(26,670)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1918.

No. 584.

THE ESTATE OF P. D. BECKWITH, INC., PETITIONER,

vs.

THE COMMISSIONER OF PATENTS.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., FEBRUARY 7, 1919.

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a *Transcript of Record.*

Court of Appeals of the District of Columbia, October Term, 1917.

Patent Appeal Docket, No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

Appeal from the Commissioner of Patents.

(Serial No. 97,233.)

Filed July 23, 1917.
Printed August 31, 1917.

Office Supreme Court, U. S. Filed Aug. 2, 1918. James D. Maher, Clerk.

1 Court of Appeals of the District of Columbia.

Patent Appeal Docket, No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

In the Court of Appeals of the District of Columbia.

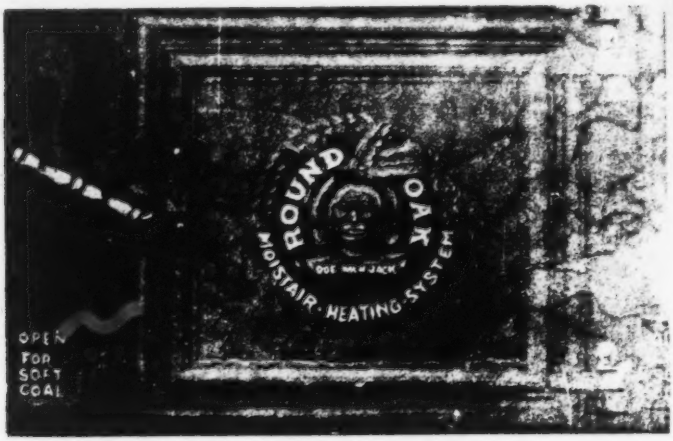
No. 1131, Patent Appeal Docket.

In re Application of the Estate of P. D. Beckwith, Inc. Serial Number 97,233. Filed August 9, 1916. Trade-mark: The Head of an Indian, the Words "Round Oak Moistair Heating System, etc., Forming and Used in the Form of a Seal.

To the Court of Appeals of the District of Columbia:

1. Your petitioner, the Estate of P. D. Beckwith, Inc., a corporation organized and existing under and by virtue of the laws of the State of Michigan, and located and doing business at the Southeast corner of Front and Beeson Streets in the City of Dowagiac, and State of Michigan, respectfully represents that it is the owner of and had adopted and continuously used since January 5, 1915, the trade-mark—Head of an Indian, the words "Round Oak Moistair Heating System," etc., forming and used in the form of a seal—on its warm air furnaces, by which it had distinguished its goods from other goods of the same class. The trade-mark is used in this manner:

2



2. That on the 9th day of August, 1916, in the manner prescribed by law, it presented its application to the Patent Office, praying that the same might be registered in the United States Patent Office according to the law in such case made and provided;

3. That such proceedings were had in said office upon said application; that on the 6th day of June, 1917, it was rejected by the Commissioner of Patents and registration for said trade-mark was refused;

4. That on the 22nd day of June, 1917, your petitioner, pursuant to Sections 4912 and 4913, Revised Statutes of the United States, gave notice to the Commissioner of Patents of its appeal to this honorable court from his refusal to register said trade-mark and grant a certificate of registration to your petitioner upon said application as aforesaid, and your petitioner filed with said Commissioner of Patents in writing its reasons of appeal;

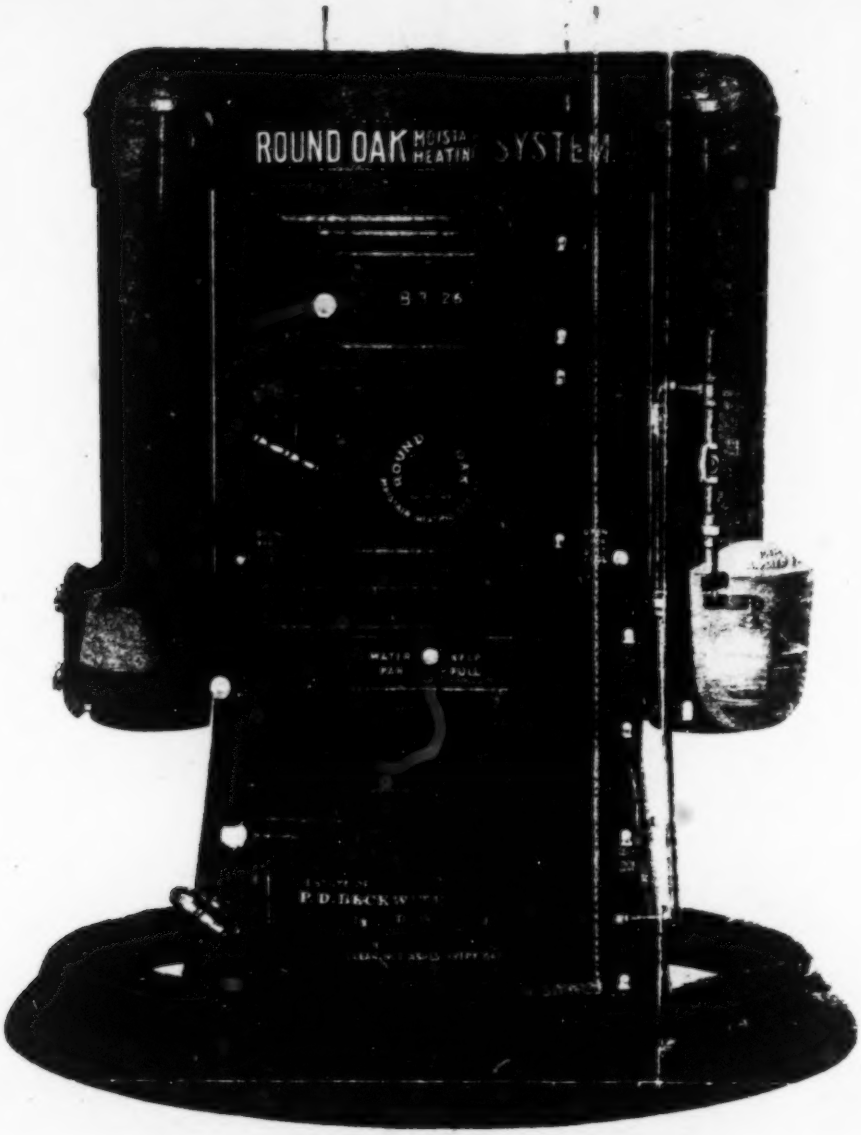
5. That the Commissioner of Patents has furnished it a certified copy of the transcript of the record and proceedings relating to said application for registration of trade-mark, which transcript is filed herewith and is to be deemed and taken as part hereof.

6. Wherefore your petitioner prays that its said appeal may be heard upon and for the reasons assigned therefor to the Commissioner of Patents, and that said appeal may be determined and the decision of the Commissioner of Patents be revised and reversed, that justice may be done in the premises.

Dated, July 18, 1917.

ESTATE OF P. D. BECKWITH, INC.,
By HARRY C. HOWARD,
Its Attorney.

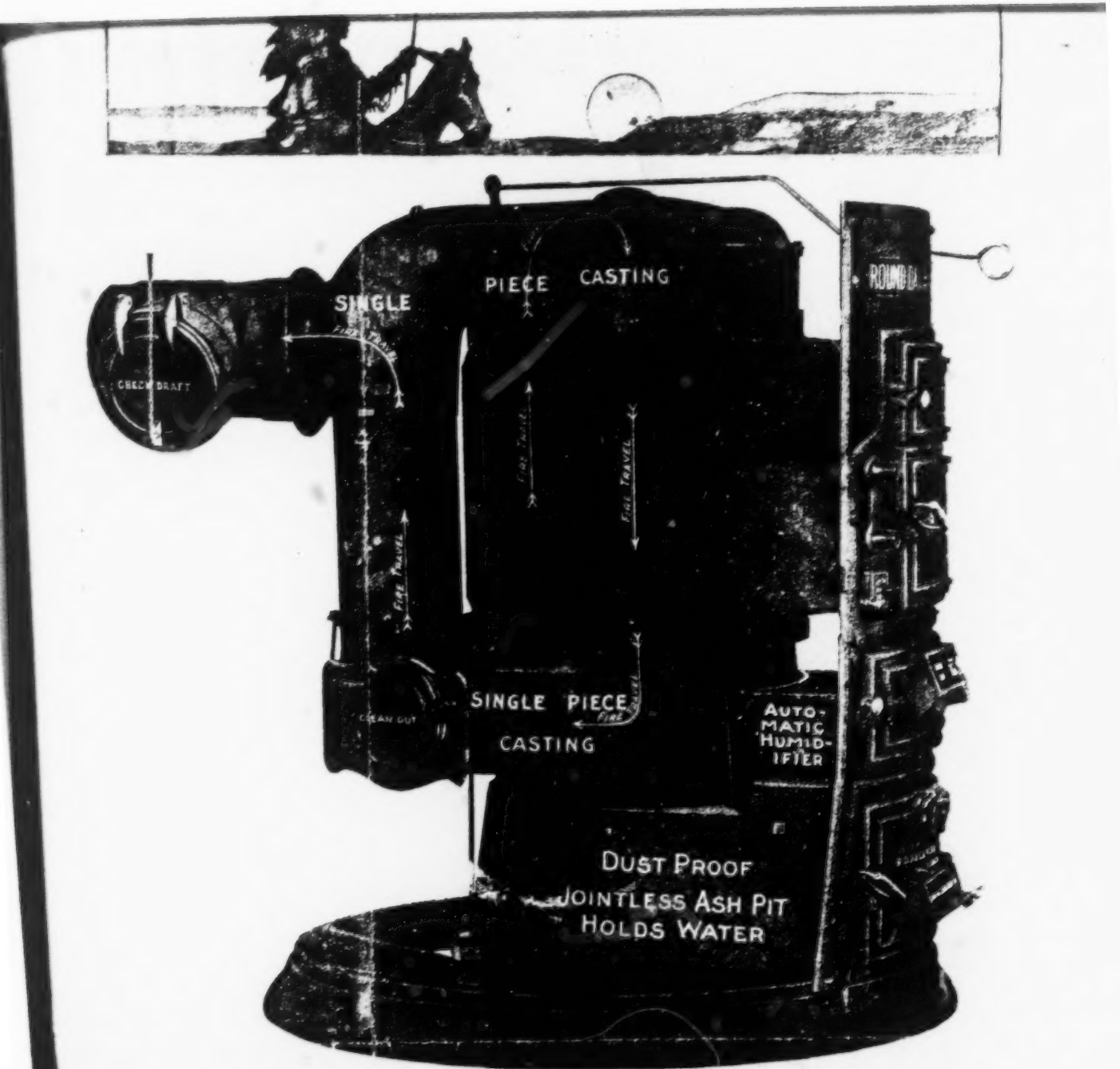
HARRY C. HOWARD,
Solicitor and of Counsel.



Round Oak Moistair Heating System

Regular Series **Front View**

Built like a battleship—fitted like a watch. Burns hard and soft coal, coke, wood, and natural gas
Note the finished product, complete in every detail



Round Oak Moistair Heating System

Regular Series Side View

Burns coal, coke, wood, and natural gas. Illustration shows arrangement of return flues, and cast horseshoe radiator, with clean-out doors; also check draft on smoke pipe, and water pan. Note single-piece castings. No leakage of smoke, gas, or dust possible. See how quickly and easily the Round Oak can be cleaned

3 [Endorsed:] In the Court of Appeals of the District of Columbia. In re Application of Estate of P. D. Beckwith, Inc. Serial Number *No.* 97,233. Filed August 9, 1916. Trade-mark: The Head of an Indian, the words "Round Oak Moistair Heating System," etc., forming and used in the form of a seal. Petition on Appeal from Decision of Commissioner of Patents. Harry C. Howard, Attorney for Petitioner, Business Address: 303 Kalamazoo Nat'l Bank Bldg., Kalamazoo, Michigan.

2-390.

United States of America,

Department of the Interior,

United States Patent Office.

To all to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the Records of this Office of the Record for the Court of Appeals of the District of Columbia in the matter of the Pending Application for the Registration of a Trade-Mark of the Estate of P. D. Beckwith, Inc., Filed August 9, 1916, Serial Number 97,233, for Heating Systems.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this 13th day of July, in the year of our Lord one thousand nine hundred and seventeen and of the Independence of the United States of America the one hundred and forty-second.

[Seal Patent Office, United States of America.]

F. W. H. CLAY,
Acting Commissioner of Patents.

(Here follows drawing marked page 4.)

4 Mail Room,
Aug. 9, 1916,
U. S. Patent Office.

$10, D'ft, Rec'd Jul- 10, 1916. J. C. C., U. S. Pat. Office.

Stamp Cancelled and Paper Returned.

Serial No. 97,233, Paper No. O. K.

Application.

Petition.

To the Commissioner of Patents:

The undersigned presents herewith a drawing and five fac similes of its trade-mark, and requests that the same, together with the accompanying statement and declaration may be registered in the United States Patent Office in accordance with the law in such case made and provided.

Dated July 25, 1916.

ESTATE OF P. D. BECKWITH, INC.,
By A. B. GARDNER,
[*As Its President.*]*
[SEAL.] *As Its Vice President & Treasurer.*

Statement.

To all whom it may concern:

Be it Known, That the Estate of P. D. Beckwith, Inc., a corporation duly organized under the laws of the State of Michigan, and located in the City of Dowagiac, County of Cass, in said State, and doing business at the [Southwest]* corner of Front, and [Beacon]* Streets, in the City of Dowagiac, and State of Michigan, has adopted and used the trade-mark shown in the accompanying drawing for

Southeast Beeson

hot air and combined hot air and hot water heaters and furnaces,

Per A. [heating systems,]* in Class Number 34, heating, lighting and ventilating apparatus, not including electrical apparatus. No claim is here made for the words "Round Oak" apart from the mark shown in the drawing, or the word "Doc-Wah-Jack" with the Indian head, as both of these are already registered as trade-marks, and no claim is made to the words "Heating System" apart from the mark shown in the drawing. [The

Per A. mark is used especially in connection with hot air and combined hot air and hot water heaters and furnaces.]*

[*Words and figures enclosed in brackets erased in copy.]

The trade-mark has been continuously used in the business
5 of said corporation since Jan'y 5-1915. The trade-mark is applied or fixed to the goods by having the same cast into the metal of which the heating systems are constructed.

Insert A'. A'.>

Dated July 25, 1916.

ESTATE OF P. D. BECKWITH, INC.,
By A. B. GARDNER,
[SEAL.] *As Its Vice-President and Treasurer.*

Declaration.

STATE OF MICHIGAN,
County of Cass, ss:

A. B. Gardner, [Fred E. Lee],* being duly sworn, deposes and says that he is the vice president and treasurer [president]* of the Estate of P. D. Beckwith, Inc., the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark in the United States, either in the identical form, or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States of the United States (and between the United States and foreign nations, and particularly with China, Japan, Russia, Turkey and other foreign nations); that the description and drawing presented truly represent the trade-mark sought to be registered; and that the fac-similes show the trade-mark as actually used upon the goods.

[SEAL.] A. B. GARDNER.

Subscribed and sworn to before me this 25 day of July, A. D. 1916.
[SEAL.] CLAYTON TORREY,
Notary Public, Cass County, Mich.

My commission expires: Apr. 7, 1919.

Paper No. 1.

Sept. 21, 1916.

Harry C. Howard, Kal. Nat'l Bank Bldg., Kalamazoo, Mich.:

Estate of P. D. Beck*s*mith, Inc. Filed August 9, 1916. Serial No 97,233.

The particular description of goods as described in lines eight, fifteen and sixteen of the statement is objected to as being

[*Words and figures enclosed in brackets erased in copy.]

6 indefinite in view of the decisions in ex parte The Empire Knife Co., 145 O. G. 763, and ex parte Newton, 160 O. G. 1037. It is suggested that the words *hot air and combined hot air and hot water heaters and furnaces* be substituted for the words "heating systems" in line eight and that the last sentence of paragraph one of the statement be canceled.

Registration is refused in that the word "Moistair" is descriptive as applied to applicant's goods. This word also should be included in the disclaimer. (Sec. 5 of the Act.)

Registration is also refused in view of the registered trade-marks

41,264, Hockaday Hardware Co., Oct. 6, 1903,
102,459, Standard Oil Co., Feb. 9, 1915,
98,467, Estate of P. D. Beckwith, Inc., July 21, 1914;
52,207, Philo D. Beckwith, Dec'd, May 1, 1906;
55,854, Philo D. Beckwith, Dec'd, Aug. 21, 1906;
56,454, Philo D. Beckwith, Dec'd, Sept. 25, 1906.

If the marks disclosed in registrations 52,207; 55,854; 56,464 and 98,467, are owned by the applicant the statement should be amended to show this fact. Upon being identified by number and date they will be withdrawn as references.

In view of the remaining registrations, namely, 41,264 and 102,459 it is held that the applicant is not entitled to disclaim the representation of an Indian's head. It should be removed from the drawing. (Ex parte Vi-Stix Products Co. 175 O. G. 847 and Fishbeck Soap Co. v. Kleeno Mfg. Co., 216 O. G. 663.)

J. CARNES, *Examiner.*

W. D. R.

The head of an Indian, the words "Round Oak", etc.

U. S. Patent Office,
Apr. 12, 1917,
Trade-marks and Designs.

Serial No. 97,233, Paper No. 2.

Am'd't A, Arg't & Letters.

Estate of P. D. Beckwith, Inc. Filed August 9, 1916. Serial No. 97,233. Trade-mark The Head of an Indian, the Word- "Round Oak," etc.

Commissioner of Patents, Washington, D. C.

DEAR SIR: In reply to paper No. 1, dated September 21st, 1916, the applicant hereby amends his statement as follows:

1. The words, "hot air and combined hot air and hot water heaters and furnaces" are hereby substituted for the words "heating systems" in the eighth line.

2. The last sentence of paragraph No. 1 is hereby canceled.
3. By adding to the statement these words:

A′ 7 Trademark 52,207, Philo D. Beckwith, Dec'd May 1, 1906;

Trademark 55,854, Philo D. Beckwith, Dec'd, Aug. 21, 1906,

Trademark 56,454, Philo D. Beckwith, Dec'd, Sept. 25, 1906, are owned by the applicant and the same were duly assigned to applicant by the following several assignments: All by Fred E. Lee, as executor, to Applicant, and recorded Feb. 16, 1907, as follows:

#52,207, recorded in Liber D, 76, p. 68, Transfer of P.;
#55,854, " " " D, 76, p. 70, " " "
#56,454, " " " D, 76, p. 72, " " "

Trademark #98,467, Estate of P. D. Beckwith, Inc., July 21, 1914, is owned by the applicant.

Dated April 10, 1917.

ESTATE OF P. D. BECKWITH, INC.,
By HARRY C. HOWARD,
At Its Attorney.

Attention is respectfully called to the fact that No. 41,264, Hockaday Hardware —, October 6, 1903, is a trade-mark which is identical with the mark here sought to be registered, nor does the mark here sought to be registered so resemble the mark in the reference "as to be likely to cause confusion or mistake in the mind of the public or deceive the purchaser."

Furthermore, we are informed that the Hockaday Hardware Company, in whose name this mark was registered, sold out their business to the Associated Simmons Hardware Company, of St. Louis, Missouri, and that for a few years following 1905, the Associated Simmons Hardware Company produced goods under this trade-mark, but for several years past, they have not done so, and at present are not producing any goods under this mark, all of which more fully appears by affidavit submitted herewith.

Reference #102,459, Standard Oil Company, February 9, 1915, relates to the trade-mark "Peerless American." It is an entirely different view than that shown in the drawing accompanying this application. It is the side view of an Indian chieftain, in full war headdress, while in the application shown in the accompanying drawing, it is the front view of an Indian chieftain with three feathers in his hair.

It is not used on the same class of goods. The statement shows that the trade-mark of the reference is used for oil cook stoves and portable dwelling house heaters, while in the case covered by the application, the mark sought to be registered is used on hot air and combined hot air and hot water heaters and furnaces, which heaters and furnaces are permanently installed in the basement of a house, while the heating apparatus which the goods in the mark referred to are either cooking stoves for use in a kitchen or the ordinary portable, tempo-

rary kerosene heating stove which is picked up and carried from room to room, suitable for use as an auxiliary heating arrangement
8 to a bath room and there is no possibility of the two being confused.

Moreover, the applicant's predecessor registered the figure of an Indian "Doe Wah Jack" Sept. 25, 1906, #56,454, long before the registration of the mark in the reference, which was not registered until February 9, 1915.

Therefore we respectfully ask that these two references be withdrawn.

In reply to the suggestion that the disclaimer be made to include that part of the mark which includes the word "Moistair" we respectfully submit that this would be a hardship upon the applicant.

Section 5, of the Act, provides that no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class, shall be *refused* registration as a trade-mark on account of the nature of such mark, *unless* such mark * * * consists * * * "merely in words or devices which are descriptive of the goods with which they are used or of the character or quality of such goods."

The construction which the Examiner has placed upon this Section overlooks the significance of the modifying word "merely." The Standard Dictionary defines the word "merely" as follows:

1. Without including anything else; purely, only, solely;
2. Absolutely, wholly.

The mark here sought to be registered is the figure of the Indian, together with the entire expression "ROUND OAK MOISTAIR HEATING SYSTEM." Thus it appears that the mark sought to be registered is not wholly descriptive of the goods or the character or quality of the goods, and applicant also respectfully urges that with the disclaimer on the words "Heating System" no part of the remaining mark is in any way descriptive.

"If it is viewed in its constituent elements, the words "Round Oak" are purely fanciful and these words have before been registered as a trade-mark by applicant or its predecessor.

This is well shown by a reference to the decision on—"Kelly Springfield Kant Slip Tread," where this language is used:

"The examiner has apparently taken the ground that descriptive and geographical words or terms, however distinctively displayed, are not registrable. Section Five of the trade-mark statute forbids the registration of marks consisting merely of words or devices that are descriptive of the goods with which they are used. The Examiner's construction of this clause seems to have ignored the word "merely." I cannot concur in *th* this contention. If a descriptive mark is sufficiently distinctively displayed, I see no reason why it is unregistrable. It would not then, in the language of the statute, be merely descriptive.

It is the mark as an entirety that the applicant asks should be registered, and as a whole, it is sufficiently arbitrary to entitle it to registration."

Ex parte, Consolidated Rubber Tire Co., 117 MS. Dec. 464.

While the applicant urges that "Moistair" standing alone is not descriptive, even if the applicant were wrong in that regard, it is
9 apparent that the mark is sufficiently distinctively displayed to come within the decision above cited.

Wherefore we respectfully urge that the mark may be registered.

Dated April 10, 1917.

ESTATE OF P. D. BECKWITH, INC.,
By HARRY C. HOWARD,
As Its Attorney.

U. S. Patent Office
Apr. 12, 1917,
Trade-marks and Designs.

United States Patent Office.

Estate of P. D. Beckwith, Inc. Filed August 1, 1916. Serial No. 97,233. Trade-mark "Round Oak Moistair Heating System."

Attorney: Harry C. Howard, 301 Kalamazoo Nat'l Bank Bldg., Kalamazoo, Mich.

STATE OF MICHIGAN,
County of Cass, ss:

John A. Howard, of the City of Dowagiac, Cass County, Michigan, being duly sworn, deposes and says that he is 42 years of age, is the Second Vice-President and Sales Manager of the applicant, and has been such for more than eleven (11) years last past and that prior thereto and for six (6) years he was a traveling salesman, selling the applicant's goods known as Round Oak Stoves, Ranges and Furnaces in the State of Ohio, and elsewhere throughout the United States and that he makes this affidavit for and in behalf of the applicant and is fully authorized so to do;

That since he began his work as traveling salesman, as aforesaid, he has devoted his entire time to selling applicant's product, and is thoroughly familiar with not only applicant's goods but with the goods of all of applicant's competitors in the field during that time and furthermore that in order to qualify himself as such salesman, he studied the history of the business, and especially that portion of it known as the furnace business.

That prior to the adoption of the above trade-mark, both the applicant's and its competitors' goods were known as "furnaces"; that this class of goods was always known as "furnaces" or "hot (or warm) air furnaces";

That in order to distinguish applicant's goods from all others, the applicant adopted the trade-mark for which registration is sought, and which is affixed to the goods in the manner as shown by the fac similes on file herein, and only in that manner, and also as more clearly appears on Exhibit A, which is hereto annexed and hereby made a part hereof;

That that portion of said mark which contains the word "Moistair" was entirely unknown to the art prior to the adoption of said
10 mark by the applicant; that it is a newly coined word, not in the dictionary, and never before used in this art;

That since its adoption there has been spent upon the mark several thousand dollars, and that during the current year of 1917, a national advertising campaign is being conducted, which together with the other advertising done in connection with said mark will involve an expenditure of $80,000.00;

That since this mark has been advertised, applicant's sales have increased so that for the year 1916 the sales aggregated 6,700 Round Oak Moistair Heating Systems as against 4,162 furnaces sold in 1914, and it is expected that during the current year of 1917, the sales will be 10,000 and upwards.

JOHN A. HOWARD.

Subscribed and sworn to before me this 10th day of March, 1917.

FLORA B. FOWLER,
Notary Public, [Cass] Kalamazoo County, Mich.*

My commission expires: May 12, 1919.

U. S. Patent Office,
Apr. 12, 1917,
Trade-marks and Designs.

United States Patent Office.

Estate of P. D. Beckwith, Inc. Filed August 9, 1916. Serial No. 97,233. Trade-mark The Head of an Indian, the Words "Round Oak," etc.

STATE OF MICHIGAN,
County of Kalamazoo, ss:

Harry C. Howard, being duly sworn, deposes and says that he is the attorney in charge of the prosecution of this application, and on noting the references from the Examiner of Trade-mark registration No. 41,264, he investigated to ascertain whether said trade-mark was longer in use by the party registering the same, and was informed that the Hockaday Hardware Company of Wichita, Kans., the registered owner of said trade-mark, had been sold to the Associated Simmons Hardware Company, of St. Louis, Missouri, and that for a few years following 1905, goods were produced under said trade-mark, but for several years past goods have not been produced or manufactured under said trade-mark, and at present are not being produced under said trade-mark.

That the foregoing information was obtained by correspondence with the firm of attorneys—Houston & Brooks, Wichita, Kans., and

[*Words and figures enclosed in brackets erased in copy.]

that after obtaining this information this affiant communi-
11 cated with the Associated Simmons Hardware Company of St. Louis, Mo., and received from it the annexed letter, which is hereby made a part hereof.

From such information as aforesaid, this affiant verily believes that said trade-mark is no longer in use, and at least as far as the Indian head is concerned, is abandoned.

HARRY C. HOWARD.

Subscribed and sworn to before me this 7th day of April A. D. 1917.

FLORA B. FOWLER.
Notary Public, Kalamazoo County, Mich.

My commission expires May 12, 1919.

December 18th, 1916.

In re Trademark "Kanokla."

Harry C. Howard, Esq., 301 Kal. Nat'l Bank Bldg., Kalamazoo, Michigan.

DEAR SIR: Your letter of December 7th, addressed to Mr. Douglas, has been referred to the writer in his absence.

The Morton-Simmons Hardware Company, of Wichita, Kansas, formerly the Hockaday Hardware Company, was the owner of this Trade-mark. I do not understand that your application includes the name "Kanokla," but only the figure of an Indian head; and the Morton-Simmons Hardware Company has no objection to the use of the Indian head Trademark by your client.

For your information, all the stock of Morton-Simmons Hardware Company, except Directors' qualifying shares, is owned by Associated Simmons Hardware Companies; but if you desire any more formal document executed by the Morton-Simmons Hardware Company and will forward it to me, I will attend to the matter.

Very truly yours,

LEWIS S. HASLAM, *Secretary.*

1 sh./am.

Paper No. 3.

Washington, April 13, 1917.

Harry C. Howard, Kal. Nat'l Bank Bldg., Kalamazoo, Mich.:

Estate of P. D. Beckwith, Inc. Filed August 9, 1916. S. N. 97, 233.

Responsive to the amendment, argument and letter filed April 12, 1917.

The refusal to register in view of the registered marks of record is withdrawn.

However, the refusal to register for the reason that "Moist-
12 air" is descriptive is repeated. See the decision in ex parte Estate of P. D. Beckwith, Inc., 122 Ms. D. 149.

Furthermore, it is believed "Moistair" is not distinctively displayed.

J. CARNES, *Examiner.*

Docket Clerk,
Apr. 26, 1917,
U. S. Patent Office

$15.00, C'k, Rec'd Apr. 26, 1917. H. C. C., U. S. Pat. Office

Serial No. 97,233, Paper No. 4.

In the United States Patent Office.

In re Application of Estate of P. D. Beckwith, Inc. Serial Number 97,233. Filed August 9, 1916. Trade-mark: Head of an Indian, the Words "Round Oak," etc., Forming and Used in the Form of a Seal.

Commissioner of Patents, Washington, D. C.

DEAR SIR: The undersigned hereby appeals to the Commissioner in person from the second and final refusal of the examiner of trade-marks to register the above mentioned trade-mark, and the applicant respectfully shows as follows:

That the trade-mark has been twice refused registration for the same reason; namely, that the examiner holds that the mark is unregistrable for the reason that in the mark as used the word "Moistair" appears and that that word is descriptive and not distinctively displayed, and therefore the mark as an entirety is refused registration.

The applicant respectfully shows that the examiner is in error in his said conclusion and that the only point to be reviewed is whether the mark in its entirety, as shown in the application, fac similes and drawings, is descriptive within the meaning of the trade-mark statute.

Enclosed is the fee of $15.00.

Dated April 24, 1917.

ESTATE OF P. D. BECKWITH, INC.,
By HARRY C. HOWARD,
As Its Attorney.

13 U. S. Patent Office,
May 8, 1917,
Mailed.

H.—F.

Paper No. 6.

United States Patent Office.

Before the Commissioner, on Appeal.

Application of Estate of P. D. Beckwith, Inc. Trade-mark for Hot Air and Combined Hot Air and Hot Water Heaters and Furnaces. Filed Aug. 9, 1916. Ser. No. 97,233.

Attorney: Harry C. Howard, Kalamazoo, Michigan.

Examiner's Statement.

This is an appeal from the refusal to register a mark for hot air and combined hot air and hot water heaters and furnaces, said mark comprising pictorial features and the words or phrases "ROUND OAK", "DOE-WAH-JACK", and "MOISTAIR-HEATING-SYSTEM". All the features are disclaimed except the word "MOISTAIR". However, the disclaimed matter has not yet been removed from the drawing, and it is believed that it should be if the disclaimer is retained. (Nairn Linoleum Company v. Ringwalt Linoleum Works, 237 O. G., 919.)

The mark is refused registration on the ground that the word "MOISTAIR" is descriptive of the goods. The term "MOISTAIR" has been held unregistrable to this applicant in a co-pending application. (*Ex parte* Estate of P. D. Beckwith, Inc., 122 MS. D., 149.)

The applicant urges that the term "MOISTAIR" is registrable because associated with other features. These other features are disclaimed, and if they are removed in accordance with the ruling in Nairn Linoleum Company v. Ringwalt Linoleum Works supra, the word "MOISTAIR" would be left standing alone, and the mark in this case would be identical with that considered in *ex parte* Estate of P. D. Beckwith, Inc., *supra*.

Moreover, even if these other features were not removed, it is not believed that the word "MOISTAIR" could be considered as distinctively displayed because of their presence. The mere association of an unregistrable word or term with other features does not render it registrable. (Ex parte The Amulet Chemical Company, 146 O. G., 719; in re Hopkins, 128 O. G., 980; and in re Crescent Typewriter Supply Company, 133 O. G., 231.)

For the reasons indicated, the refusal to register is deemed proper.

Very respectfully, J. CARNES,
Examiner Trade-marks and Designs.

H. H.

May 8, 1917.

14 Docket Clerk,
May 14, 1917,
U. S. Patent Office.

Serial No. 97,233, Paper No. 8.

In the United States Patent Office.

In re Application of Estate of P. D. Beckwith, Inc. Serial Number 97,233. Filed August 9, 1916. Trade-mark: Head of an Indian, the Words "Round Oak", etc., Forming and Used in the Form of a Seal.

The examiner's statement on appeal alludes to a disclaimer of certain words and that these words are yet upon the drawing, and therefore the mark may not be registered.

The disclaimer is withdrawn, and the statement amended accordingly by striking out—

"No claim is here made for the words "Round Oak" apart from the mark shown in the drawing, or the word "Doe-Wah-Jack", with the Indian Head, as both of these are already registered as trademarks, and no claim is made to the words "Heating System" apart from the mark shown in the drawing.

Dated May 14, 1917.

ESTATE OF P. D. BECKWITH, INC.,
By HARRY C. HOWARD,
As Its Attorney.

Serial No. 97,233, Paper No. 9.

Recorded, Vol. 123, P. 136.

Hearing May 15, 1917. M. C. V.

United States Patent Office.

Ex Parte Estate of P. D. Beckwith, Inc.

Application for Registration of Trade-mark.

Appeal.

Trade-mark for Heating Systems.

Application filed Aug. 9, 1916, No. 97,233.

Mr. Harry C. Howard for applicant.

This is an appeal from the refusal of registration to applicant's composite trade-mark for heaters, on the ground of descriptiveness.

The applicant had disclaimed various features previously and separately registered to him, leaving descriptive words only. By permission at the hearing he has withdrawn the disclaimer.

With the incorporation of the amendment filed May 14, 1917, the applicant's mark consists of the whole combination figure in the drawing. This is a design like a seal, comprising the head of an Indian chief surmounting a scroll bearing his name, "Doc-
15 Wah-Jack," and surrounded by a circle, outside of which appear the words "Round Oak" and "Moistair Heating System" in a circle, and the whole being surrounded by a wreath of oak leaves. Apparently the applicant has an exclusive right to all these features except the phrase "Moistair Heating System" and it has in common with the public generally also a right to use, though not to register, these descriptive words.

The words "Moistair Heating System" must of course be disclaimed; the real question is whether a mere verbal disclaimer is sufficient, or whether the disclaimer must take the form of removal from the drawing. It is probably true that the presence of these words on the seal design would not lead an observer to suppose they were an essential part of the mark; but on the other hand it appears quite feasible to remove them without destroying the essential mark, and in such case any doubts should be removed by erasing them. The mark will be registered upon removal of the words "Moistair Heating System." To this extent the decision of the examiner is reversed.

F. W. H. CLAY,
Assistant Commissioner.

June 6, 1917.

Mail Room,
Jun- 25, 1917,
U. S. Patent Office.

Docket Clerk,
Jun- 25, 1917,
U. S. Patent Office.

Serial No. 97,233, Paper No. 11.

In the United States Patent Office.

In re Application of Estate of P. D. Beckwith, Inc. Serial Number 97,233. Filed August 9, 1916. Trade-mark: Head of an Indian, the Words "Round Oak," etc., Forming and Used in the Form of a Seal.

To the Commissioner of Patents:

You are hereby notified of my appeal to the Court of Appeals of the District of Columbia from your decision rendered June 6th, 1917, on the hearing had May 15th, 1917, rejecting the above entitled application for the registration of the trade-mark, and refusing to register the trade-mark in said application set forth.

The following are assigned as the reasons of appeal:

1. Because the Honorable Commissioner of Patents erred in re-

jecting registration on the ground that some of the words in the mark were descriptive.

2. Because under the statute in such case made and provided, the mark should have been registered.

3. Because said mark does not consist merely in words or devices which are descriptive of the goods with which it is used or of the character or quality of the goods.

4. Because the mark sought to be registered is "suggestive", and not descriptive.

5. Because said mark does not impart positive information as to the quality or characteristic of the goods.

16 6. Because the mark as an entirety does not consist in words which are merely descriptive within the meaning of the Trade-mark statute.

Dated June 22, 1917.

ESTATE OF P. *B.* BECKWITH, INC.,
By HARRY C. HOWARD,
As Its Attorney.

(Here follows diagram marked page 17.)

[Endorsed:] 98,396/17.

34
Heating Systems

ARK
97235

68
9

Estate of P. D. Beckwith, Inc.
By: A. B. Darahus
Co-Trustee Vice President & Treasurer
Proprietor

No 1131. Circuit appeal docket.
In the matter of the Application of the Estate of P. D. Beckwith, Inc. } Page 28

28

Docket Clerk,
Aug. 20, 1917,
U. S. Patent Office.

In the Court of Appeals of the District of Columbia.

Patent Appeal Docket, No. 1131.

In re Application of the Estate of P. D. Beckwith, Inc. Serial — 97,233. Filed August 9, 1916. Trade-mark: The Head of an Indian, the Words "Round Oak Moistair Heating System, etc., Forming and Used in the Form of a Seal.

It is hereby stipulated by and between appellant and the United States Patent Office that the annexed cut may be used in the Printed Record on Appeal in place of cut used in the proceedings in Patent Office with like force and effect as if an exact copy of the cut used in the Patent Office were printed. This stipulation is made as the cut used in the Patent Office is out of print and the annexed cut is in all material respects the same.

Dated August 17, 1917.

HARRY C. HOWARD,
Attorney for Appellant.
THEODORE A. HOSTETLER,
For U. S. Patent Office.

[Endorsed:] No. 1131. In the Matter of the Application of P. D. Beckwith, Inc. Stipulation of Counsel as to Drawing. Court of Appeals, District of Columbia. Filed Aug. 23, 1917. Henry W. Hodges, Clerk.

(Here follows drawing marked page 30, can be seen at page 4.)

Endorsed on cover: Commissioner of Patents. Patent appeal docket, No. 1131. In the matter of the application of the estate of P. D. Beckwith, Inc. Court of Appeals, District of Columbia. Filed Jul- 23, 1917. Henry W. Hodges, clerk.

18 Monday, March 11th, A. D. 1918.

No. 1131.

In the Matter of the Application of the Estate of P. D. Beckwith, Inc.

The argument in the above entitled cause was commenced by Mr. H. C. Howard, attorney for the appellant, and was continued by Mr. T. A. Hostetler, attorney for the Commissioner of Patents, and was concluded by Mr. H. C. Howard, attorney for the appellant.

19 In the Court of Appeals of the District of Columbia.

Patent Appeal, No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

Opinion.

Mr. Justice VAN ORSDEL delivered the opinion of the Court:

This appeal is from the decision of the Commissioner of Patents denying the application of appellant for the registration of the following trade-mark for "hot air and combined hot air and hot water heaters and furnaces:"

The Commissioner tendered registration of the figure with the words "Moistair Heating System" eliminated, which appellant refused—hence this appeal. The reason assigned by the Commissioner is that "applicant has an exclusive right to all these features except the phrase 'Moistair Heating System,' and it has in common with the public generally also the right to use, but not to register, these descriptive words."

The Trade-Mark Act of February 20, 1905, (33 Stats. L., 724,) in section 5, among other things, provides: "That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some
20 particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act."

It must be conceded that the words "Moistair Heating System" are descriptive of the merchandise on which the mark is used and for which registration is sought. These words, standing alone, are clearly unregisterable, and are open to public use, limited only by the principles involved in unfair competition. If these words constitute an essential feature of the trade-mark, it is sufficient to defeat registration. A mark, certain features of which are merely suggestive of character or quality, is one thing; but a mark like the present, which contains as its dominant feature words aptly descriptive of the character or quality of the goods to which it is applied, is quite another thing. In such cases, where the descriptive words are the dominant feature of the mark, registration should be denied. Johnson vs. Brandau, 32 App. D. C., 348; In re Schweinfurter, 38 App. D. C., 279; In re Excelsior Shoe Co., 40 App. D. C., 480; Re Motz Tire & Rubber Co., 40 App. D. C., 487.

The statute not only prohibits the registration of marks which are descriptive, but of marks which would be likely to cause confusion in trade. "Moist Air Heating System" is the trade-name of a large class of merchandise. There are numerous styles of "hot air and combined hot air and hot water heaters and furnaces" manufactured and on the market, on which the owners are entitled to use the common designation here sought to be monopolized. The statute does not contemplate that the Commissioner shall register a mark with descriptive words in it, and wait until another applies for registration of the same or a similar mark before he can apply the restriction as to confusion. It is sufficient if the mark is known to be in use, or its equivalent, a trade-name common to a large class of merchandise, upon one branch of which it is sought by the
21 applicant, through the agency of registration, to monopolize the use of the mark. In the matter of the registration of trade-marks, the Commissioner represents the public. The section of the statute here in question relates primarily to the protection of the public, and the controlling provision is that which forbids the registration of any mark which may lead to confusion in trade. That being true, the uniform holding of this court that registration of marks will be refused in which descriptive words constitute the dominating feature, will be adhered to.

The attempt to register a trade-name which would damage others engaged in handling the same class of merchandise to which the mark is applied and for which registration is sought, has generally been held to constitute a ground for opposition proceedings. In Johnson vs. Brandau, supra, sustaining the opposition on the ground that the opposer had used the mark merely as a trade-name, the court said: "If registration be allowed, it becomes prima facie evidence of the appellant's ownership of it as a valid trademark * * * in any action which he may institute against the opposer or others who may use the word as a general trade-name for similar articles of goods. Having used the word as such a tradename, although not entitled to ownership of it as a trademark, we think it is permissible for the opposer to make opposition to the registration by the applicant." In Natural Food Co. vs. Williams, 30 App. D. C.,

348, involving the right to register the mark "Shredded Whole Wheat," when it appeared that the opposer had never used the words as a trade-mark, the court said: "That he (the opposer) did not use the words as a trademark, but merely in a descriptive sense, is of no moment. He, in common with all other manufacturers of shredded whole wheat, had the same right to properly designate their product as did the Natural Food Company."

The term or trade-name "Moist Air Heating System" is generic, and is descriptive of specific articles of manufacture belonging to one general class of merchandise. The name is common to all, and may be aptly used as descriptive of each. Such a name may not be monopolized as a trade-mark. In Standard Paint Co. vs.
22 Trinidad Asphalt Co., 220 U. S., 446, 453, the court, considering the validity of the word "Rubberoid" as a trade-mark for paint, said: "The Asphalt Company also makes a roofing, not, however, of the same material as that of the Paint Company, but of the same thickness as the latter, and cut in the similar widths and lengths, and sells it under the name of 'Rubbero' roofing. Two contentions are made by the Paint Company: (1) That its trade-mark is a valid one and has been infringed by the Asphalt Company. (2) That the latter has been guilty of unfair competition. The Court of Appeals decided adversely to both contentions. 163 Fed. Rep., 977. Of the first contention the court said it was clear that the Paint Company 'sought to appropriate the exclusive use of the term rubberoid,' and that its rights were to be adjudged accordingly, and that as the latter, being a common descriptive word, could not be appropriated as a trade-mark, the one selected by the Paint Company could not be appropriated. The court said: 'A public right in rubberoid and a private monopoly of rubberoid cannot coexist.' The court expressed the determined and settled rule to be 'that no one can appropriate as a trade-mark a generic term or one descriptive of an article of trade, its qualities, ingredients or characteristics, or any sign, word or symbol which from the nature of the fact it is used to signify others may employ with equal truth.' "

By indisputable analogy, it follows that to give the statute the force intended by Congress, primarily to protect the public against confusion in trade, the Commissioner may anticipate inevitable confusion and refuse to grant a monopoly in a mark which is not only descriptive in its dominant features, but contains the common trade-name of similar commodities in a general class of merchandise. If an applicant can register descriptive words or trade-names camouflaged in immaterial and deceptive trimmings, the whole purpose of the statute would be nullified. To uphold such procedure amounts to countenancing the perpetration of a fraud in the face of the clear intent of Congress. The conclusion, when measured in the light of the evident purpose of the statute, seems to be
23 irresistible. It is so just and so manifestly in accord with the spirit of the law that a different interpretation should not be indulged through any technical, fine-spun, literal construction of the statute.

Opportunity was given appellant in the Patent Office to eliminate

from his mark the words "Moistair Heating System," and accept registration of the fanciful portions of the design. Clearly this is all to which he is entitled. It, however, can be accomplished only by elimination from the registered mark, and not merely by filing a disclaimer in the Patent Office. Johnson vs. Brandau, supra; Electro Steel Co. vs. Lindenberg Steel Co., 43 App. D. C., 270; Fishbeck Soap Co. vs. Kleeno Mfg. Co., 44 App. D. C., 6.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

24 In the Court of Appeals of the District of Columbia.

Patent Appeal, No. 1131.

Mr. Chief Justice SMYTH, concurring specially:

I concur in the opinion and judgment of Mr. Justice Van Orsdel on the ground of stare decisis. It seems to me that if the rule so often announced by this court either directly or indirectly is to be changed, it should be done by Congress and not by the Court. If, however, the question was one of first impression, I would join in the conclusion announced by Mr. Chief Justice McCoy.

25 In the Court of Appeals of the District of Columbia.

Patent Appeal, No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

Mr. Justice McCOY dissents:

The statute concerning the registration of trade-marks provides among other things as follows:

"That the owner of a trademark used in commerce * * * may obtain registration for such trademark by complying with the following requirements: (Here follows provisions in relation to the application for registration.)

"Sec. 2. That the application * * * must be accompanied by a written declaration * * * to the effect that the applicant believes himself * * * to be the owner of the trademark sought to be registered; * * * that such trademark is used in commerce * * *.

"That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark consists of or comprises immoral or scandalous matter. (Sec. 5*a*.)

"Consists of or comprises the flag, coat of arms, or other insignia of the United States * * *.

"Provided, That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they

are used or the character or quality of such goods * * * shall be registered under the terms of this act." (Sec. 5*b*.)

It has been decided by this Court that a trade-mark which comprises words merely descriptive cannot be registered, but that is not what the statute says. I cannot see that the proviso in regard to the use of descriptive words needs to be construed for the language is perfectly plain, but if I am wrong in this then the proper con-
26 struction of it is made certain by other parts of the section; namely, those where the statute reads "*consists* of or *comprises*." (Italics mine.)

The trademark law is nothing but a registration act. Elgin Watch Co. v. Illinois Watch Co., 179 U. S. 665-672. In refusing registration to marks consisting merely in words or devices which are descriptive the act codified the law found in the decisions because a mark of that kind was not given protection in equity, Brown Chemical Co. v. Myer, 139 U. S. 540-542. Nothing else was decided in Standard Paint Co. v. Trinidad Asphalt Co., 220 U. S. 446, cited in the present opinion of Mr. Justice Van Orsdel.

A so-called common law trademark containing descriptive words is protected in equity. Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169. McLean v. Fleming, 96 U. S. 51; page 56 and passim. Williams v. Mitchell, 106 Fed. Rep. 168-171. Leather Cloth Co. v. American Leather Cloth Co., House of Lords cases (1864-1866) vol. 11, 523. Siexo v. Provexende, (1865) 1 Law Rep. 191. Redway v. Banham (1896) App. Cases 199. Montgomery v. Thompson, (1891) Appeal Cases Law Reports, 217. Raggett v. Findlater, (1873) 17 Eq. Cases, 29. Russia Cement Co. v. Lepage, 147 Mass. 206, 211.

In the brief for the Commissioner of Patents it is stated as follows:

"The recent decisions of the courts, such as Nairn Linoleum Co. v. Ringwait Linoleum Works; O. W. Thum Company v. Dickinson, and others that have interpreted the statutes, have to some extent changed the practice in the Patent Office, which Office is governed by the decisions of the courts."

This is a respectful way of saying that the decisions of this Court have revolutionized the practice in the Patent Office so far as concerns the matter here in question.

The decisions of this Court in cases where registration has been refused to trademarks comprising descriptive words seem to be based upon some intention of Congress said to be expressed in the proviso which reads as follows:

"That trademarks which are identical with a registered or
27 known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties or which so nearly resemble a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties is likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered."

and in the present opinion of Mr. Justice Van Orsdel he says:

"The statute not only prohibits the registration of marks which are descriptive, but of marks which would be likely to cause confusion in trade."

So it does, provide that the confusion likely to arise would come from the registration of a mark identical with a registered or known trademark or so nearly resembling a registered or known trademark as to be likely to cause confusion. Counsel for the Commissioner of Patents does not contend that the mark here in question is identical with or resembles any registered or known trademark, and the Commissioner of Patents did not refuse registration on either of these grounds.

It is said that in the matter of registration of trademarks that the Commissioner represents the public. So does any other public official but he misrepresents the public if he acts in contravention of the statute. If Congress intended to make him a chancellor it was also very careful to limit the scope of his powers.

I do not find any warrant in the statute for permitting an applicant to secure registration of a trademark after eliminating any part thereof. The statute is clearly against such practice for it says as already quoted that it is "the owner of a trademark used in commerce" who is entitled to have it registered. He can register only what he has used. Elgin Watch Co. v. Illinois Watch Co. (supra) where the Court said:

"Trademarks are not defined by the act, which assumes their existence and ownership, and provides for a verified declaration by applicants for registration that they have the exclusive right
28 to the particular trademark sought to be registered."

I dissent though I would not do so had the previous decisions of this Court established a rule of property.

29 Monday, May 27th, A. D. 1918.

* * * * * * *

April Term, 1918.

No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

Subject Matter: Trademark for Heating Systems. Serial No. 97,233.

Appeal from the Commissioner of Patents.

This cause came on to be heard on the transcript of the record from the Commissioner of Patents and was argued by counsel. On consideration whereof, It is now here ordered and adjudged by this Court that the decision of the said Commissioner of Patents in this cause be and the same is hereby affirmed.

PER MR. JUSTICE VAN ORSDEL.

May 27, 1918.

Mr. Justice McCoy dissenting.

30 Court of Appeals of the District of Columbia.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 29 inclusive constitute a true copy of the transcript of record and proceedings of said Court of Appeals, in the case of In the Matter of the Application of the Estate of P. D. Beckwith, Inc., No. 1131, Patent Appeal Docket, April Term, 1918, as the same remain upon the files and records of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this 18th day of June, A. D. 1918.

[Seal Court of Appeals, District of Columbia, 1893.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

31 UNITED STATES OF AMERICA, *ss:*

[Seal of the Supreme Court of the United States.]

The President of the United States of America to the Honorable the Judges of the Court of Appeals of the District of Columbia, Greeting:

Being informed that there is now pending before you a suit entitled In the matter of the application of the Estate of P. D. Beckwith, Inc., No. 1131, Patent Appeals Docket, which suit was removed into the said Court of Appeals by virtue of an appeal from the Commissioner of Patents, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Court of Appeals and removed into the
32 Supreme Court of the United States, do hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Edward D. White, Chief Justice of the United States, the seventh day of November, in the year of our Lord one thousand nine hundred and eighteen.

JAMES D. MAHER,
Clerk of the Supreme Court of theUnited States.

[Endorsed:] 1131. File No. 26,670. Supreme Court of the United States, October Term, 1918. No. 584. The Estate of P. D. Beckwith, Inc., vs. The Commissioner of Patents. Writ of Certiorari.

Court of Appeals District of Columbia. Filed Nov. 18, 1918. Henry W. Hodges, Clerk.

33 In the Court of Appeals of the District of Columbia.

Patent Appeal, No. 1131.

In the Matter of the Application of the ESTATE OF P. D. BECKWITH, INC.

The Supreme Court of the United States having under date of November 7, 1918, issued its writ of certiorari to the above Court in the above entitled cause, it is hereby stipulated by and between the attorneys for the respective parties as follows:

1. That the certified transcript of record on file in the Supreme Court of the United States in connection with the application for said writ of certiorari may be taken as a return to the writ.

2. That the Clerk of this Court is requested to send to the Clerk of the Supreme Court of the United States as such return to said writ a certified copy of this stipulation.

Dated November 9, 1918.

HARRY C. HOWARD,
Attorney for Appellant.
JNO. W. DAVIS,
Solicitor General.

(Endorsed:) In the Matter of the Application of the Estate of P. D. Beckwith, Inc., Patent Appeal No. 1131. Stipulation. Court of Appeals, District of Columbia. Filed Nov. 29, 1918. Henry W. Hodges, Clerk.

34 I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify, in obedience to the writ of certiorari hereto attached and returned herewith, the foregoing to be a true and correct copy of the stipulation of counsel filed in said cause on the 29th day of November, A. D. 1918.

In testimony whereof, I hereunto subscribe my name and affix the seal of said Court at the City of Washington, District of Columbia, this 29th day of November, A. D. 1918.

[Seal Court of Appeals, District of Columbia, 1893.]

HENRY W. HODGES, *Clerk.*

[Endorsed:] 584. 26670.

35 [Endorsed:] File No. 26,670. Supreme Court U. S., October Term, 1918. Term No. 584. The Estate of P. D. Beckwith, Inc., Petitioner, vs. The Commissioner of Patents. Writ of Certiorari and Return. Filed November 29, 1918.

Office Supreme Court, U. S.
FILED
AUG 2 1918
JAMES D. MAHER,
Clerk.

IN THE

SUPREME COURT

OF THE UNITED STATES.

OCTOBER TERM, A. D. 1918.

No. 5[redacted]178

IN THE MATTER OF THE APPLICATION
of
THE ESTATE OF P. D. BECK, WITH, INC.

Patent Appeal No. 1137.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF.

HARRY C. HOWARD,
Attorney for Petitioner.

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IN THE
SUPREME COURT OF THE UNITED STATES
October Term, A. D. 1918.

No.

In the Matter of the Application of the Estate of P. D .Beckwith, Inc. } Patent Appeal No.1131.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

PETITION FOR WRIT OF CERTIORARI.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE UNITED STATES:

The petition of the Estate of P. D. Beckwith, Inc., a corporation organized and existing under and by virtue of the laws of the State of Michigan, and having its principal office and doing business in the City of Dowagiac, in the State of Michigan, respectfully represents and shows unto your Honors as follows:

I.

The petitioner is the owner of and has adopted and continuously used since January 5, 1915, a fanciful trade-mark in the form of a seal, which is cast into the cast iron door of its warm air furnaces and by which it has distinguished its goods from others of the same class.

The trade-mark consists of the head of an Indian, and the words "DOE-WAH-JACK",

"ROUND OAK MOISTAIR HEATING SYSTEM." It is used in the following manner:

II.

That on August 9th, 1916, in the manner prescribed by law, it presented its application to the Patent Office, praying that the same might be registered in the United States Patent Office, according to the law in such case made and provided.

III.

That such proceedings were had in said office upon said application; that on the 6th day of June, 1917, it was rejected by the Commissioner of Patents and registration for said trade-mark was refused; the Commissioner, however, saying that the mark would be registered if the words "Moistair Heating System" were removed.

IV.

That on the 22nd day of June, 1917, your petitioner, pursuant to Sections 4912 and 4913, Revised Statute of the United States, gave notice to the Commissioner of Patents of its appeal to the Circuit Court of Appeals of the District of Columbia from refusal of the Commissioner of Patents to register said trade-mark, and grant a certificate of registration to your petitioner upon the application as aforesaid. Your petitioner filed with said Commissioner of Patents in writing, its reasons of appeal, and duly perfected its appeal.

V.

That on March 11, 1918, the matter was argued orally before the Court of Appeals for the District of Columbia, Mr. H. C. Howard arguing for the petitioner, and Mr. T. A. Hostetler arguing for the Commissioner of Patents. Records and briefs were theretofore filed in accordance with the statute and rules and practice of said court.

VI.

That on to-wit, the 27th day of May, 1918, the said Court of Appeals of the District of Columbia, affirmed the decision of the Commissioner of Patents.

VII.

That the question which was at issue and argued before said Court of Appeals for the District of Columbia involved an interpretation and construction of the Federal trade-mark statute; that it was urged upon behalf of your petitioner that the statute was a registration statute and it was

mandatory upon the Commissioner of Patents to register the mark unless it consisted of or comprised a mark which was "merely descriptive", and that the Commissioner of Patents had no power to impose upon the applicant for registration of the trade-mark the requirement that he should eliminate any part of his mark, for if such a requirement were complied with, the applicant for registration would then have a registered mark which he had not used, and the basis of the registration is the use of the mark.

The learned counsel representing the Commissioner of Patents urged that the Commissioner had the power to require an applicant for registration to eliminate from his mark any words which might in any way be descriptive and that the earlier decisions of that Court were to that effect; that at the time of the argument, the Court was constituted and consisted of Mr. Justice Van Orsdel, Mr. Justice McCoy, and Mr. Chief Justice Smyth. In disposing of the issue so presented, each of said Justices filed an opinion; Mr. Justice Van Orsdel sustaining the right of the Commissioner to impose the requirement and holding the mark to be descriptive within the meaning of the earlier decisions of that Court. Mr. Justice McCoy filed a dissenting opinion, holding that the trade-mark statute was a registration statute and pointing out that the earlier decisions of the Court cited by Mr. Justice Van Orsdel "seemed to be based upon some intention of Congress said to be expressed in the proviso", which in general relates to a confusion between trade-marks of different parties, pointing out in that connection that your petitioner's mark was not refused registration for the reason which seems to have been the basis of the earlier decisions of said Court, and holding that the Commis-

sioner of Patents had no power to make the requirement that any portion of the mark as used be eliminated.

Mr. Chief Justice Smyth "concurred specially" with the opinion of Mr. Justice Van Orsdel, saying:

> "I concur in the opinion and judgment of Mr. Justice Van Orsdel on the ground of **stare decisis.** It seems to me that if the rule so often announced by this court either directly or inferentially is to be changed, it should be done by Congress and not by the Court. If, however, the question was one of first impression, I would join in the conclusion announced by Mr. Justice McCoy."

VIII.

That to show the matters aforesaid and as a part of this petition, your petitioner respectfully files and submits herewith a duly authenticated copy of the record filed in the Court of Appeals of the District of Columbia, containing a duly authenticated copy of the opinions of said Court affirming the decision of the Commissioner of Patents.

IX.

Your petitioner shows that said Court of Appeals for the District of Columbia misinterpreted and misconstrued the trade-mark statute and that it erred in sustaining the decision of the Commissioner of Patents requiring your petitioner to eliminate from its trade-mark the words "Moist-air Heating System" as a condition precedent to registration.

Wherefore your petitioner prays that a writ of certiorari be issued out of and under the seal of this court, directed to the Circuit Court of Appeals for the District of Columbia, commanding said Court to certify and send to this court on a day certain to be therein designated a full and complete transcript of the record and all proceedings of said Circuit Court of Appeals in this case, which are entitled in that court, to the end that said cause may be reviewed and determined by this court as provided by law, and that the judgment of said Court of Appeals for the District of Columbia may be reversed by this Honorable Court.

ESTATE OF P. D. BECKWITH, INC.,
By Harry C. Howard,
As its Attorney.

STATE OF MICHIGAN, }
County of Kalamazoo, } ss

Harry C. Howard, being duly sworn, deposes and says that he is the attorney for Estate of P. D. Beckwith, Inc., the plaintiff above named, and verifies this petition for and in its behalf and is duly authorized so to do; that he has read the foregoing petition and knows the contents thereof and that the same is true in substance and matter of fact.

HARRY C. HOWARD.

Subscribed and sworn to before me
this 11th day of July, 1918.

FLORA B. FOWLER,
Notary Public, Kalamazoo County, Mich.
My commission expires May 12, 1919.

I hereby certify that I have examined the foregoing petition, and in my opinion, the petition is well founded and that the case is one in whch the

prayer of the petitioner should be granted by this court.

HARRY C. HOWARD.
Attorney for Petitioner.

SIRS:

Please take notice that upon a certified copy of the transcript of record herein and upon the annexed petition of Estate of P. D. Beckwith, Inc., sworn to the 11th day of July, 1918, I shall submit the annexed petition for writ of error to the Supreme Court of the United States at the Capitol in the City of Washington, District of Columbia, on Monday, the 14th day of October, 1918, at the opening of court on that day or as soon thereafter as counsel can be heard. This petition is based upon the certified copy above mentioned and the printed record and briefs filed in this matter.

Dated July 11, 1918.

Yours, etc.,
HARRY C. HOWARD,
Attorney for Petitioner,
303 Kalamazoo Nat'l Bank Bldg.,
Kalamazoo, Mich.

To Mr. T. A. Hostetler, attorney, who appeared for the Commissioner of Patents on Argument Below, and

To the Commissioner of Patents.

BRIEF IN SUPPORT OF PETITION.

Statement.

This is an application for writ of certiorari to the Circuit Court of Appeals of the District of Columbia to review its decision affirming the action of the Commissioner of Patents in requir-

ing the petitioner as a condition precedent to the registration of its trade-mark to remove from its trade-mark a part thereof.

The sole question is the power of the Commissioner of Patents under the Federal trade-mark act of February 20, 1905, 33 Stat. L. 724, to make the requirement that the petitioner strike out any part thereof.

The three Judges of the Court of Appeals each filed separate and distinct opinions, from which opinions it clearly appears that the majority of the Court were persuaded that the petitioner's position was well taken, but that because of some earlier decisions of the Court of Appeals, the majority of that Court voted against its own convictions and in favor of affirming the decision of the Commissioner of Patents.

Mr. Justice Van Orsdel wrote the majorty opinion. Mr. Justice McCoy wrote the dissenting opinion, and Mr. Chief Justice Smyth "concurred specially" in the opinion of Mr. Justice Van Orsdel on the ground that it was stare decisis, saying:

> "It seems to me that if the rule so often announced by this Court, either directly or inferentially, is to be changed, it should be done by Congress and not by the Court. **If, however, the question was one of first impression, I would join in the conclusion announced by Mr. Justice McCoy."** (Black face ours).

The question upon this application for certiorari is whether or not the Court of Appeals correctly interpreted, applied and construed the Federal trade-mark Act of February 20, 1905, 33 Statute, 724.

BRIEF OF ARGUMENT.

The trade-mark Act provides that the owner of a mark may, by complying with the terms of the Act, have its trade-mark registered in the Patent Office. The petitioner met all the requirements of the Act, and was refused registration solely and only because, in the opinion of the Commissioner, the words "Moistair Heating System" appearing at the base of the seal-like design were thought by the Commissioner to be descriptive; the Commissioner saying:

> "The mark will be registered upon removal of the words "Moistair Heating System." To this extent the decision of the Examiner is reversed."
> Record, p. 15.

The material portions of the statute are quoted at the beginning of the dissenting opinion of Mr. Justice McCoy, found at page 25 of the certified copy accompanying the petition. For convenience, however, we again set it out here:

"That the owner of a trademark used in commerce * * * may obtain registration for such trademark by complying with the following requirements: (Here follow provisions in relation to the application for registration).

"Sec. 2. That the application * * * must be accompanied by a written declaration * * * to the effect that the applicant believes himself * * * to be the owner of the trademark sought to be registered; * * * that such trademark is used in commerce * * *.

"That no mark by which the goods of the owner of the mark may be distinguished from

other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark consists of or comprises immoral or scandalous matter. (Sec. 5a).

"Consists of or comprises the flag, coat of arms, or other insignia of the United States * *.

"Provided, That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used or the character or quality of such goods * * * shall be registered under the terms of this act." (Sec. 5b).

The opinion of the Commissioner of Patents seems to turn upon the question that the words in question are not displayed in distinctive type, but they do not "comprise" the trademark sought to be registered. The mark is sought to be registered in its entirety. The use of the mark, which is the basis of the registration, comprises the entire mark as an entity.

A reading of the Act shows conclusively that it is a mere registration act, and Congress was careful in the terms used to refrain from giving the Commissioner of Patents any judicial discretion whatsoever.

The Act says:

> "No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration, unless it consists of or comprises the flag, coat of arms, or other insignia of the United States." * **
>
> "Provided, that no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used or the character

> or quality of the goods * * * shall be registered under the terms of this act."

The petitioner having complied with all the terms of the act, the law expressly says that the Commissioner shall not refuse to register the mark, unless the mark "consists of or comprises" words which are merely descriptive.

The Commissioner found that the mark in question "consisted of and comprised" the following: (and not merely descriptive words)

> "This is a design like a seal, comprising the head of an Indian chief surmounting a scroll bearing his name, "Doe-Wah-Jack" and surrounded by a circle, outside of which appear the words "Round Oak" and "Moistair Heating System" in a circle, and the whole being surrounded by a wreath of oak leaves. Apparently the applicant has the exclusive right to all these features except the phrase "Moistair Heating System", and it has in common with the public generally also a right to use, though not to register, these descriptive words."
>
> Record, p. 14.

It is thus seen that the Commissioner of Patents himself concluded that this trade-mark did not "consist" **merely in words or devices which are descriptive.**

The statute does not prohibit the registration of marks in which a descriptive phrase is used. It prohibits only the registration of a mark which consists of or comprises matter which is **"merely descriptive."**

The case at bar is not one where the applicant

has sought by the use of a mere geometrical figure to obtain the registration of a mark otherwise unregisterable, as was done in the case of—

Nairn Linoleum Company vs. Ringwalt Linoleum Works, 237 O. G. 919,

and as was done in the case of—

Strauss vs. Notaseme Company, 240 U. S. 179.

This case was a typical instance in which the applicant used words otherwise descriptive in connection with a mere geometrical figure and they were allowed registration in the Patent Office in the first instance on disclaiming any intention to register the descriptive term.

A practice grew up in the Patent Office of filing a disclaimer and obtaining the registration of the mark. This opened the door for fraud and allowed the registrant to disclaim unregisterable matter and then later in practice to actually claim the entire mark, including the unregisterable matter; in other words, he was allowed to use a mere geometrical figure as a vehicle to carry descriptive terms through to a successful registration.

The majority opinion, after discussing the statute and the decision, says:

> "Opportunity was given applicant in the Patent Office to eliminate from his mark the words "Moistair Heating System" and accept registration of the fanciful portions of the design. Clearly this is all to which he is entitled. It, however, can be accomplished only by elimination from the registered mark, and not merely by filing a disclaimer in the Patent Office. * * *

> The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required."

This interpretation of the statute does violence to the statute itself. The statute says that no mark shall be refused registration unless it "consists of or is comprised of" a mark **"merely** in words or devices which are descriptive of the goods with which they are used."

Mr. Justice McCoy says of this:

> "I cannot see that the proviso in regard to the use of descriptive words needs to be construed for the language is perfectly plain, but if I am wrong in this, then the proper construction of it is made certain by other parts of the section; namely, those where the statute reads **"consists** of or **comprises."**

It is apparent that whether reference be had to the majority opinion or to the opinion of the Commissioner of Patents, the conclusion is inevitable that each of them concluded that there was something fanciful about the mark.

The Commissioner described the mark as a fanciful mark—See quotation from his opinion earlier in this brief.

The majority opinion just quoted refers to the "fanciful portion of the design", so we are confronted squarely with the question of whether in a fanciful design the use of any word which is in any way descriptive will prevent its registration.

It has long been the practice and the profession generally have understood that it was allowable to use in fanciful designs such as this, words

which were clearly descriptive, for example, we anticipate that no difficulty would have arisen had we used instead of the words "Moistair Heating System" the word "stove' or "furnace", or perchance as is often done, the word "trade-mark" itself. The writer of the majority opinion, however, expresses the idea that the words found to be objectionable are the dominant features of the mark. In expressing this idea the learned Justice confuses the mark in the case at bar, with the mark is such cases as the Linoleum case and Notaseme case where there was no fanciful design—merely a meaningless geometrical figure.

The statute, however, is a mere registration statute and it does not say that a trade-mark which has prominently displayed in it a descriptive word may not be registered. Quite to the contrary, it contains the mandate that the Commissioner of Patents **shall not refuse to register** unless it is comprised of words **"merely** descriptive."

The earlier decisions referred to in the majority opinion deal with cases where there was controversy about the confusion of the mark and some one was contesting the applicant's right to registration, on the ground that to allow the registration would be to create confusion in the trade, the contestant in each instance showing that the mark sought to be registered was a thing open to the public and that he, the contestant, had been using it, and the strongest of those cases are the cases where bare geometrical figures were used as mere vehicles to carry unregisterable matter to a successful registration. At the outset of the majority opinion is quoted this portion of the statute—"that trade-marks which are identical with a registered or known trade-mark, owned and in use

by another and appropriated to merchandise of the same descriptive properties, or which so nearly resembled a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered."

The Commissioner did not refuse registration on the ground that the mark here sought to be registered would create any confusion or violate the property rights of any one else. In fact, he finds affirmatively that we are entitled to the use of all the mark, but that there are some words in the mark which are descriptive—open to everybody; that is, open to the world at large and these he seeks to have us eliminate.

This distinction is pointed out clearly in the dissenting opinion and shows the error in the majority opinion. Mr. Chief Justice Smyth "concurred specially" in the majority opinion, but it is apparent that he does so with many misgivings because he places it solely on the ground of stare decisis, and then announces in so many words that were it not for these decisions, had the matter come to his mind as an original proposition, his judgment would be otherwise, which is another way of saying that having erred before, the error should be perpetuated, because a precedent however erroneous is so binding that it cannot be disturbed without an act of the legislative body.

Mr. Chief Justice Smyth was in error in concluding the question here to be "stare decisis" as he had in mind the decisions of which the Linoleum case is typical; for the time he overlooked the distinction that in such cases a mere geometrical figure was used for the sole purpose of car-

.ying a descriptive term to a successful registration.

However, a further act of congress is unnecessary to overrule the previous decisions of the Court of Appeals if the decisions are susceptable of the construction placed upon it by the majority opinion. The trade-mark act, February 20, 1905, 33 Stat. L. 724, plainly says that **no mark shall be refused registration** unless it is **comprised of** matter which is merely descriptive. Certainly the mark here is not wholly comprised of descriptive matter. Both the Commissioner and the majority opinion of the court below found it to be fanciful; in fact, until the decision in the Linoleum case, marks containing descriptive as well as other terms were always registered. The practice was so well settled in the Patent Office in this regard that we need to cite but one case, which is a typical case:

Kelly Springfield
Kant Slip Tread.

The mark was rejected by the examiner, who assigned the folowing reasons:

> "Kelly" was said to be an ordinary surname;
> "Springfied" is geographical;
> "Kant Slip Tread" is descriptive,

and the Commissioner used the following language:

> "The examiner has cited certain decisions which in effect held that the words under consideration were not sufficiently

distinctively displayed and I cannot construe those decisions as going farther than the marks under consideration. * * *

"Whether or not the use of the word "Kelley alone, or "Kant Slip' alone would infringe this mark is not now before the office, and need not be considered.

"The examiner has apparently taken the ground that descriptive and geographical words or terms, however distinctively displayed, are not registrable. Section Five of the trade-mark statute forbids the registration of marks consisting of words or devices that are descriptive of the goods with which they are used. The examiner's construction of this clause seems to have ignored the word "merely." I cannot concur in this contention. If a descriptive mark is sufficiently distinctively displayed, I see no reason why it is unregistrable. It would not then, in the language of the statute, be merely descriptive.

"It is only the mark as an entirety that the applicant asks should be registered, and as a whole, it is sufficiently arbitrary to entitle it to registration.'

Ex parte, Consolidated Rubber Tire Co., 117 Ms. Dec| 464, Aug. 14, 1915.

J. F. Newton, 1st Asst. Com.

The decision of the Patent Office follows the reasonable construction of the statute. No one would say on reading the statute that it meant to prohibit the registration of **all descriptive terms.** It is only those which are "merely so", and giving to the word "merely" its usual meaning; that is

to say, "without including anything else; purely, only, solely, absolutely, wholly", it is apparent that the intention of Congress was to allow the registration of marks such as involved in this appeal.

This practice was followed until recently when through a misunderstanding of the statute the Patent Office (due to the Linoleum case) "revolutionized" its practice.

The statute requires the applicant for registration to make a statement in writing showing the manner in which the mark is applied to goods, also drawings, etc., and to file fac similes or specimen of the mark. That was done in this case and the mark used is the one shown on the furnace door,

Record, p. 2.

To strike out any of the mark would be to allow action upon an application which showed the use and fac similes of a different mark. There could be no objection to using a descriptive word with this mark, such as "stoves", "ranges", "furnaces", or trade mark. To add a word, which if the examiner's conclusion is correct, is a word of limitation, still leaves the mark well within the terms of the act itself. If the suggestion of the Commissioner were adopted and the words erased from the drawing, the applicant's registration would be on a mark which never had been used and its use is the foundation for registration this would be impossible.

A large business has been built upon this mark. Thousands of dollars have been spent in advertising the goods of the applicant so that the buying public might know that whenever and wherever it bought a heating system with that seal upon its door, it bought quality and the buying public has grown to rely upon that seal as a guarantee is

shown by substantiative proof to that effect offered in the proceedings before the Patent Office tribunal. It is shown that the advertising expenditure for 1917 upon these goods will amount to $80,000.00, and that the use of the goods has become so general that the sales for 1917 will be 10,000 heating systems and upwards, as against 4,162 sold in 1914.

Record, p. 10.

In view of the fact that the public have learned to rely upon this seal as a guarantee; in view of the fact that the continued use of this mark has brought the applicant within the act and that the act says that no mark by which the goods of the owner may be distinguished from other goods of the same class shall be refused registration, unless "comprised" of matter **"merely"** descriptive, we earnestly urge that the decision of the court below be reversed and that applicant be allowed registration upon the mark as in the form and manner used and that it be left to the courts in the future if the applicant seeks to take an unfair or unlawful advantage of such registration to enter a decree which will protect and save harmless others who may be entitled to the use of any words which in any way may be open to the public.

It is fair to assume that the language of the court in the Notaseme case will encourage not only this applicant for registration, but all others, not to grasp "for too much and thereby lose all." This we urge is a matter which if it should arise is for the courts to deal with instead of the Commissioner of Patents under this registration statute which gives him no judicial discretion. We respectfully urge that the operation of this act of Congress be not defeated by the technicality suggested, based not on the mark in its entirely, but

only upon a separation of the mark into its constituent elements.

The principal for which we argue here is the same principle to which the courts have had recourse in sustaining claims in combination patents, where the courts have frequently held that the invention resides in the combination of the elements (rather than in a single element however dominating) whose correlation produces a new thing not unlike a chemical compound;

Elizabeth vs. Pavement Co., 97 U. S. 126; 24 L. Ed. 1000.

So we say that the Court below erred in concluding that the way to consider the mark was to separate it into all its constituent elements instead of considering it in its entirety, "like a new chemical compound", and we urge that its decision be reversed to the end that the time, effort and energy spent to protect the public by giving it this guarantee of quality, this seal by which the owner distinguished his goods from the goods of others of the same class, and that full effect thereby be given to the act of Congress, providing for the protection not only of the owner of the mark but all those who have occasion to place reliance upon it.

We respectfully submit that the importance of this matter should bear heavily against a majority opinion against the convictions of the Court, joined in for no better reason than **"stare decisis"** and which a casual glance at the act of Congress must show is entirely wrong and a violence to the intent of Congress.

We respectfully urge that this writ of certiorari be issued so as not only to give full force and effect to the act but to settle for all time its proper construction to the end that justice may be done

to those having occasion to ask the benefit of this registration act.

Respectfully submitted.
HARRY C. HOWARD,
Attorney for Petitioner.

July 10, 1918,
Kalamazoo, Mich.

SUPREME COURT OF THE UNITED STATES

October Term, 1918.

No. 584.

THE ESTATE OF P. D. BECKWITH, INC., Petitioner,

vs

THE COMMISSIONER OF PATENTS.

On writ of Certiorari to the Court of Appeals of

the District of Columbia.

BRIEF FOR PETITIONER.

STATEMENT

November 7, 1918, this court issued its writ of certiorari to the Court of Appeals of the District of Columbia.

The petition for the writ of certiorari was filed August 2, 1918.

The certiorari and return were filed November 29, 1918.

The writ is to review the decision of the Circuit Court of Appeals of the District of Columbia affirming the action of the Commissioner of Patents in requiring the petitioner, as a condition precedent to the registration of its trade mark, to remove from the trade mark a part thereof. The trade mark is found

(Transcript of Record, p. 2)

For convenience it is also here inserted.

The sole question is the power of the Commissioner of Patents, under the Federal Trade Mark Act of February 20, 1905,

(33 Stat. L. 724)

to make the requirement that the petitioner strike out any part of its trade mark as used by it.

The three Judges of the Court of Appeals each filed separate and distinct opinions, from which opinions it clearly appears that the majority of the Court were persuaded that the petitioner's position was well taken, but that because of some earlier decisions of the Court of Appeals, the majority of that Court voted against its own convictions and in favor of affirming the decision of the Commissioner of Patents.

Mr. Justice Van Orsdel wrote the majority opinion. Mr. Justice McCoy wrote the dissenting opinion, and Mr. Chief

Justice Smyth "concurred specially" in the opinion of Mr. Justice Van Orsdel on the ground that it was stare decisis, saying:

> "It seems to me that if the rule so often announced by this Court, either directly or inferentially, is to be changed, it should be done by Congress and not by the Court. **If, however, the question was one of the first impression, I would join in the conclusion announced by Mr. Justice McCoy.**"
>
> (Transcript of Record, p. 21)

The question for discussion is whether the Court of Appeals of the District of Columbia correctly interpreted, applied and construed the Federal Trade Mark Act of February 20, 1905.

(33 Stat. L. 724)

BRIEF OF ARGUMENT.

The Trade Mark Act provides that the owner of a mark may, by complying with the terms of the Act, have its trademark registered in the Patent Office. The petitioner met all the requirements of the Act, and was refused registration solely and only because, in the opinion of the Commissioner, the words "Moistair Heating System" appeared at the base of the seal-like design, were thought by the Commissioner to be descriptive; the Commissioner saying:

> "The mark will be registered upon removal of the words 'Moistair Heating System'. To this extent the decision of the Examiner is reversed."
>
> (Transcript of Record, p. 15)

Three judges sat in the Court of Appeals for the District of Columbia when the appeal from the Patent Office was argued. Three opinions were filed. Mr. Justice Van Orsdel's opinion is found

(Transcript of Record, p. 18)

The opinion of Mr. Chief Justice Smyth, concurring specially, is found

Transcript of Record, p. 21)

The opinion of Mr. Justice McCoy, dissenting, is found

(Transcript of Record, p. 21)

The material portions of the Trade-Mark Statute are set out in the beginning of the dissenting opinion, and we set them out here for convenience:

> "That the owner of a trade-mark used in commerce ***** may obtain registration for such trade-mark by complying with the following requirements:" (Here follow provisions in relation to the application for registration).
>
> "Sec. 2. That the application ***** must be accompanied by a written declaration *** to the effect that the applicant believes himself *** to be the owner of the trade-mark sought to be registered *** that such trade-mark is used in commerce **.
>
> That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark consists of or comprises immoral or scandalous matter. (Sec. 5a)

> Consists of or comprises the flag, coat of arms, or other insignia of the United States *****.
>
> Provided, That no mark which consists ***** merely in words or devices which are descriptive of the goods with which they are used or the character or quality of such goods **** shall be registered under the terms of this act." (Sec. 5b)

The opinion of the Commissioner of Patents seems to turn upon the question that the words in question are not displayed in distinctive type, but they do not "comprise" the trade-mark sought to be registered. The mark is sought to be registered in its entirety. The use of the mark, which is the basis of the registration, comprises the entire mark as an entity.

A reading of the Act shows conclusively that it is a mere registration Act, and Congress was careful in the terms used to refrain from giving the Commissioner of Patents any judicial discretion whatsoever. The act says:

> "No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be **refused registration,** unless it consists of or comprises the flag, coat of arms, or other insignia of the United States."***
>
> "Provided, that no mark which consists ***** merely in words or devices which are descriptive of goods with which they are used or the character or quality of the goods **** shall be registered under the terms of this Act."

The petitioner, having complied with all the terms of the Act, the Act expressly says, "No mark **** shall be re-

fused registration" unless the mark "consists of or comprises" words which are "merely descriptive of the goods with which they are used or the character or quality of the goods".

The Commissioner, in his opinion, said that the mark in question "consisted of and comprised" the following:

> "**This is a design like a seal, comprising** the head of an Indian chief surmounting a scroll bearing his name, 'Doe-Wah-Jack' and surrounded by a circle, outside of which appear the words 'Round Oak' and 'Moistair Heating System' in a circle, and the whole being surrounded by a wreath of oak leaves. Apparently the applicant has the exclusive right to all these features except the phrase 'Moistair Heating System', and it has in common with the public generally also a right to use, though not to register, these descriptive words."
>
> (Transcript of Record, 15)

The statute uses these words: "consists of or comprises". In speaking of the mark, the Commissioner tells exactly in the above quotation of what it is comprised, and it is apparent that the Commissioner himself concluded that this trade-mark did not "consist" **merely in words or devices which are descriptive.** The Act does not forbid the registration of marks **in which descriptive phrases are used.** It only prohibits the registration of a mark which consists of or is comprised of matter which is "merely descriptive".

The case at bar is not one where the applicant has sought by the use of a mere geometrical figure to obtain the registration of a mark otherwise unregisterable, as was done in the case of

Nairn Linoleum Company v. Ringwalt Linoleum Works, 237 O. G. 919,

and as was done in the case of

Strauss v. Notaseme Company, 240 U. S. 179.

This case was a typical instance in which the applicant used words otherwise descriptive in connection with a mere geometrical figure and they were allowed registration in the Patent Office in the first instance on disclaiming any intention to register the descriptive term.

A practice grew up in the Patent office of filing a disclaimer and obtaining the registration of the mark. This opened the door for faud and allowed the registrant to disclaim unregisterable matter and then later in practice to actually claim the entire mark, including the unregisterable matter; in other words, he was allowed to use a mere geometrical figure as a vehicle to carry descriptive terms through to a successful registration.

The majority opinion, after discussing the statute and the decision, says:

> "Opportunity was given applicant in the Patent Office to eliminate from his mark the words 'Moistair Heating System' and accept registration of the fanciful portions of the design. Clearly this is all to which he is entitled. It, however, can be accomplished only by elimination from the registered mark, and not merely by filing a disclaimer in the Patent Office. ****
>
> The decision of the Commissioner of Patents is is affirmed, and the clerk is directed to certify these proceedings as by law required."
>
> Transcript of Record, 21

This interpretation of the statute does violence to the

statute itself. The statute says that no mark shall be refused registration unless in "consists of or is comprised of" a mark "**merely** in words or devices which are descriptive of the goods with which they are used." Mr. Justice McCoy says of this:

> "I cannot see that the proviso in regard to the use of descriptive words needs to be construed for the language is perfectly plain, but if I am wrong in this, then the proper construction of it is made certain by other parts of the section; namely, those where the statute reads 'consists of or comprises.' "
>
> (Transcript of Record, 22)

It is apparent that whether reference be had to the majority opinion of the Court of Appeals, or to the opinion of the Commissioner of Patents, the conclusion is inevitable that each of them concluded that there was something fanciful about the mark. Not merely descriptive.

The Commissioner described the mark as a fanciful mark. See quotation from his opinion earlier in this brief.

The majority opinion just quoted refers to the **"fanciful portion of the design"**, so we are confronted squarely with the question of whether in a **fanciful dsign the use of any word which is in any way descriptive will prevent its registration.**

It has long been the practice, and the profession generally have understood, that it was allowable to use in fanciful designs such as this, words which were clearly descriptive; for example, we anticipate that no difficulty would have arisen had we used, instead of the words "Moistair Heating System" the word "stove" or "furnace", or perchance as is often done, the word "trade-mark" itself. The writer of

the majority opinion, however, expresses the idea that the words found to be objectionable are the dominant features of the mark. In expressing this idea the learned Justice confuses the mark in the case at bar, with the mark in such cases as the Linoleum case and the Notaseme case, where there was **no fanciful design—merely a meaningless geometrical figure**

The statute, however, is a mere registration statute, and it does not say that a trade-mark which has prominently displayed in it a descriptive word may not be registered. Quite to the contrary, it contains the mandate that the Commissioner of Patents **shall not refuse to register** unless it is comprised of words "**merely** descriptive."

The earlier decisions referred to in the majority opinion deal with cases where there was controversary about the confusion of the mark and some one was contesting the applicant's right to registration, on the ground that to allow the registration would be to create confusion in the trade, the contestant in each instance showing that the mark sought to be registered was a thing open to the public and that he, the contestant, had been using it, and the strongest of those cases are the cases where bare geometrical figures were used as mere vehicles to carry unregisterable matter to a successful registration. At the outset of the majority opinion is quoted this portion of the statute:

> "that trade-marks which are identical with registered or known trade-marks, owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resembled a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the

> same descriptive properties, as to be likely to cause confusion or mistake in the public mind, or to deceive purchasers, shall not be registered."

The Commissioner did not refuse registration on the ground that the mark here sought to be registered **would create any confusion or violate the property rights of any one else.** In fact, he finds affirmatively that we are entitled to the use of all the mark, but that there are some words in the mark which are descriptive—open to everybody; that is, open to the world at large, and these he seeks to have us eliminate.

(Transcript of Record, p. 15)

This distinction is pointed out clearly in the dissenting opinion and shows the error in the majority opinion. Mr. Chief Justice Smyth "concurred specially" in the majority opinion, but it is apparent that he does so with many misgivings because he places it solely on the ground of **stare decisis,** and then announces in so many words that were it not for these decisions, had the matter come to his mind as an original proposition, his judgment would be otherwise, which is another way of saying that having erred before, the error should be perpetuated, because a precedent, however erroneous, is so binding that it may not be disturbed without an Act of the legislative body.

Mr. Chief Justice Smyth was in error in concluding the question here to be "stare decisis" as he had in mind the decisions of which the Linoleum case is typical; for the time he overlooked the distinction that in such cases a mere geometrical figure was used for the sole purpose of carrying a descriptive term to a successful registration.

However, a further act of Congress is unnecessary to over-

rule the previous decisions of the Court of Appeals if the decisions are susceptible of the construction placed upon them by the majority opinion. The trade-mark Act, February 20, 1905

(33 Stat. L. 724)

plainly says that **no mark shall be refused registration** unless it is **comprised of** matter which is merely descriptive. Certainly the mark here is not wholly comprised of descriptive matter. Both the Commissioner and the majority opinion of the court below found it to be fanciful; in fact, until the decision in the Linoleum case, marks containing descriptive as well as other terms were always registered. The practice was so well settled in the Patent Office in this regard that we need to cite but one case, which is a typical case:

This mark was rejected by the examiner, who assigned the following reasons:

> "Kelly" was said to be an ordinary surname;
> "Springfield" is geographical;
> "Kant Slip Tread" is descriptive,

and the Commissioner used the following language:

> "The examiner has cited certain decisions which in effect held that the words under consideration were not sufficiently distinctively displayed and I cannot construe those decisions as going farther than the marks under consideration. ****

"Whether or not the use of the word 'Kelly' alone, or 'Kant Slip' alone would infringe this mark is not now before the office, and need not be considered.

"The examiner has apparently taken the ground that descriptive and geopraphical words or terms, however distinctively displayed, are not registerable. Section Five of the trade-mark statute forbids the registration of marks consisting of words or devices that are descriptive of the goods with which they are used. The examiner's construction of this clause seems to have ignored the word 'merely'. I cannot concur in this contention. If a descriptive mark is sufficiently distinctively displayed, I see no reason why it is unregisterable. It would not then, in the language of the statute, be merely descriptive.

"It is only the mark as an entirety that the applicant asks should be registered, and as a whole, it is sufficiently arbitrary to entitle it to registration."

Ex parte, Consolidated Rubber Tire Co. 117 Ms. Dec. 464, Aug 14, 1915.

J. F. Newton, 1st Asst. Com.

This decision of the Patent Office follows the reasonable construction of the statute. No one would say on reading the statute that it meant to prohibit the registration of **all descriptive terms.** It is only those which are **"merely so"**, and giving to the word merely its usual meaning; that is to say, "without including anything else; purely, only, solely, absolutely, wholly", it is apparent that the intention of Congress was to allow the registration of marks such as involved in this appeal.

This practice was followed until recently when through

a misunderstanding of the statute the Patent Office (due to the Linoleum case) "revolutionized" its practice.

The statute requires the applicant for registration to make a statement in writing showing the manner in which the mark is applied to goods, also drawings, etc., and to file fac similes of specimen of the mark. That was done in this case, and the mark used is the one shown on the furnace door.

(Transcript of Record, p. 2.)

To strike out any of the mark would be to allow action upon an application which showed the use and fac similes of a different mark. There could be no objection to using a descriptive word with this mark, such as "stoves", "ranges", "furnaces", or "trade-mark". To add a word, which if the examiner's conclusion is correct, is a word of limitation, still leaves the mark well within the terms of the act itself. If the suggestion of the Commissioner were adopted and the words erased from the drawing, the applicant's registration would be on a mark which never had been used, and as its use is the foundation for registration, this would be impossible.

If the mark were registered omitting the words suggested by the Commissioner, and later some one were to infringe upon the rights of the owner of the mark, it might be necessary to apply for an injunction restraining the infringer. It is entirely probable that if such a thing should occur, it might be successfully urged in the defense of an action for infringement, that the owner of the mark had registered something which he had not in fact used. He has used the mark as shown on the furnace door,

(Transcript of Record, p. 2)

and he has not used the mark suggested by the Commissioner,

who would have the registration upon the mark used on the furnace door, omitting a part of the seal-like design, and it is entirely possible that the owner of the mark might lose all his rights if he accepted and acted upon the suggestion of the Commissioner, which the majority opinion of the Court of Appeals affirms.

A large business has been built upon this mark. Thousands of dollars have been spent in advertising the goods of the applicant so that the buying public might know that whenever and wherever it bought a heating system with that seal upon its door, it bought quality; and the buying public has grown to rely upon that seal as a guarantee is shown by substantiative proof to that effect offered in the proceedings before the Patent Office tribunal. It is shown that the advertising expenditure for 1917 upon these goods will amount to $80,000.00, and that the use of the goods has become so general that the sales for 1917 will be 10,000 heating systems and upwards, as against 4,162 sold in 1914.

(Transcript of Record, p. 10)

In view of the fact that the public have learned to rely upon this seal as a guarantee; in view of the fact that the continued use of this mark has brought the applicant within the act and that the act says that no mark by which the goods of the owner may be distinguished from other goods of the same class shall be refused registration, unless "comprised" of matter "merely" descriptive, we earnestly urge that the decision of the court below be reversed and that applicant be allowed registration upon the mark as in the form and manner used, and that it be left to the courts in the future, if the applicant seeks to take an unfair or unlawful advantage of such registration, to enter a decree which will protect and save harmless others

who may be entitled to the use of any words which in any way may be open to the public.

It is fair to assume that the language of the court in the Notaseme case will encourage not only this applicant for registration, but all others, not to grasp "for too much and thereby lose all". This we urge is a matter which if it should arise is for the courts to deal with instead of the Commissioner of Patents under this **registration statute which gives him no judicial discretion.** We respectfully urge that the operation of this act of Congress be not defeated by the technicality suggested, based not on the mark in its entirety, but only upon a separation of the mark into its constituent elements.

The principle for which we argue here is the same principle to which the courts have had recourse in sustaining claims in combination patents, where the courts have frequently held that the invention resides in the combination of the elements (rather than in a single element, however dominating) whose correlation produces a new thing not unlike a chemical compound;

Elizabeth v. Pavement Co. 97 U. S. 126; 24 L. Ed. 1000.

So we say that the court below erred in concluding that the way to consider the mark was to separate it into all its constituent elements instead of considering it in its entirety, "like a new chemical compound". We urge that its decision be reversed to the end that the time, effort and energy spent to protect the public by giving it this guarantee of quality—this seal by which the owner distinguished his goods from the goods of others of the same class—may not fail, and that full effect thereby be given to the Act of Congress, providing for the

protection, not only of the owner of the mark, but all those who have occasion to place reliance upon it.

We respectfully submit that the importance of this matter should bear heavily against a majority opinion against the convictions of the Court—joined in for no better reason than "stare decisis", and which a casual glance at the Act of Congress must show is entirely wrong and a violence to the intent of Congress.

A reading of the majority opinion by Mr. Justice Van Orsdel,

(Transcript of Record, pp. 18, 19, 20)

indicates that he thought the Commissioner should be allowed to anticipate a possible confusion in the public mind. He reasons that because words which he construes to be descriptive are contained in the mark, possibly the public might in some way be confused; and he reasons that the object of the statute was to protect the public, and therefore that the Commissioner was justified in anticipating what Mr. Justice Van Orsdel terms "inevitable confusion."

The difficulty with that line of reasoning it that the statute is a registration statute, and tells in clear language exactly what may be registered, and the statute is a mandatory statute. It says:

> "No mark *** shall be **refused** registration ** Provided, that no mark which consists **** merely in words or devices which are descriptive of the goods with which they are used or the character or quality of the goods *** shall be registered under the terms of this act."

Mr. Justice McCoy aptly says:

> "I cannot see that the proviso in regard to the use of descriptive words needs to be construed for the lang uage is perfectly plain, but if I am wrong in this then the proper construction of it is made certain by other parts of the section; namely, those where the statute reads **'consists'** of or **comprises.** The trademark law is nothing but a registration Act."
>
> Elgin Watch Co. v. Illinois Watch Co., 179 U. S. 665-672.

> "In refusing registration to marks consisting merely in words or devices which are descriptive the act codified the law found in the decisions because a mark of that kind was not given protection in equity.
>
> Brown Chemical Co. v. Myer, 139 U. S. 540-542.

Nothing else was decided in

> Standard Paint Co. v. Trinidad Asphalt Co. 220 U. S. 446,

cited in the present opinion of Mr. Justice Van Orsdel.

A so-called common law trademark containing descriptive words is protected in equity.

> Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169.
>
> McLean v. Flemming, 96 U. S. 51; page 56 and passim.

> Williams v. Mitchell, 106 Fed. Rep. 168-171.
>
> Leather Cloth Co. v. American Leather Cloth Co.,
>
> House of Lords cases (1864-1866) vol 11, 523.

Siexo v. Provexende, (1896) 1 Law Rep. 191.
Redway v. Banham (1896) App. Cases 199.
Montgomery v. Thompson, (1891) Appeal cases Law Reports, 217.

Raggett v. Findlater, (1873) 17 Eq. Cases, 29.
Russia Cement Co. v. Lepage, 147 Mass. 206, 211.
(Transcript of Record, p. 22)

Mr. Justice McCoy, speaking of the brief filed on behalf of the Commissioner of Patents, quoted from it these words:

> " 'The recent decisions of the courts, such as Nairn Linoleum Co. v. Ringwalt Linoleum Works, O. W. Thum Company v. Dickinson, and others that have interpreted the statutes, have to some extent changed the practice in the Patent Office, which office is governed by the decisions of the courts.' "

Continuing, Mr. Justice McCoy said of this language:

> "This is a respectful way of saying that the decisions of this Court have revolutionized the practice in the Patent Office so far as concerns the matter here in question."
> (Transcript of Record, p. 22)

Mr. Justice McCoy then points out that the decisions of the Court of Appeals of the District of Columbia, where registration had been refused to trade-marks comprising descriptive words, seemed to be based upon the intention of Congress said to be expressed in the proviso, which reads as follows:

> "That trademarks which are identical with a regis-

tered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties or which so nearly resemble a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties is likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered."

(Transcript of Record, p. 22)

And in the present opinion of Mr. Justice Van Orsdel he says:

> "The statute not only prohibits the registration of marks which are descriptive, but of marks which would be likely to cause confusion in trade."

Mr. Justice McCoy says:

> "So it does, provided that the confusion likely to arise would come from the registration of a mark identical with a registered or known trademark or so nearly resembling a registered or known trademark as to be likely to cause confusion. Counsel for the Commissioner of Patents does not contend that the mark here in question is identical with or resembles any registered or known trademark, and the Commissioner of Patents **did not refuse** registration on either of these grounds.
>
> It is said that in the matter of regitration of trademarks the Commissioner represents the public. So does any other public official; but he misrepresents the public **if he acts in contravention of the statute.** If Cong-

ress intended to make him a chancellor it was also very careful to limit the scope of his powers.

> **I do not find any warrant in the statute for permitting an applicant** to secure registration of a trademark after eliminating any part thereof. The statute is clearly **against** such practice for it says, as already quoted, that it is "the owner of a trademark **used** in commerce" who is entitled to have it registered. He can register only what he has used.
>
> Elgin Watch Co. v. Illinois Watch Co. (supra)"
>
> (Transcript of Record, p. 21)

We respectfully urge that the decision of the court below should be reversed in order that full force and effect may be given to the Act of Congress, and in order to settle for all time the proper construction of the Act itself, to the end that justice may be done to those having occasion to ask the benefit of this registration Act.

Respectfully submitted,

HARRY C. HOWARD,
Attorney for Petitioner.

Dated: September 22, 1919.

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In the Supreme Court of the United States.

OCTOBER TERM, 1919.

THE ESTATE OF P. D. BECKWITH, INC., Petitioner,
v.
THE COMMISSIONER OF PATENTS. } No. 178.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF ON BEHALF OF THE COMMISSIONER OF PATENTS.

STATEMENT.

This case presents for construction the second proviso, section 5, of the trade-mark act of February 20, 1905, relating to the registration of trade-marks. This proviso reads:

> That no mark which consists merely * * * in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, shall be registered under the terms of this act. (For entire section of the act, see page 16 of this brief.)

The Court of Appeals of the District of Columbia affirmed the Commissioner of Patents in refusing to register a trade-mark containing descriptive matter in combination with matter properly registerable.

In presenting this brief the Commissioner of Patents wishes to be understood not as defending his decision as affirmed by the Court of Appeals, but rather as assisting the court in obtaining a general perspective of the Patent Office practice in cases of this nature as it has been affected by various leading decisions of the Court of Appeals of the District of Columbia.

The Patent Office tribunals have, of course, been governed by these decisions, and the Commissioner of Patents was so governed in rendering his decision in the present case.

FACTS OF THE CASE.

On August 1, 1916, the petitioner filed an application for the registration of a trade-mark for heating systems. This mark consisted of the head of an Indian, with the words "Doe-Wah-Jack" beneath, and the words "Round Oak" above, the whole surmounted by a semicircular wreath, the circle being completed by the words "Moistair Heating System." The application contained the following statement:

> No claim is here made for the words "Round Oak" apart from the mark shown in the drawing, or the word "Doe-Wah-Jack" with the Indian head, as both of these are already

> registered as trade-marks, and no claim is made to the words "Heating System" apart from the mark shown in the drawing. (Rec., p. 4.)

Registration was refused by the examiner in charge of trade-marks on the ground that the word "Moistair" is descriptive as applied to applicant's goods and should therefore be included in the disclaimer, citing the decision of the commissioner in another application in which it had been sought to register this word alone and where registration has been refused. (Rec., p. 12.)

(The designation of the goods upon which the mark was used had been changed by the applicant from "heating systems" to "hot air and combined hot air and hot water heaters and furnaces." Rec., p. 6.)

Appeal was taken to the Commissioner of Patents, but one day prior to the hearing the application was amended withdrawing the disclaimer, thereby presenting on appeal the mark in its original entirety, as used. (Rec., p. 14.)

The Commissioner of Patents held that apparently the applicant had exclusive right to all the features of the mark except the phrase "Moistair Heating System" and that "it has in common with the public generally also the right to use, though not to register, these descriptive words." The commissioner stated:

> * * * the real question is whether a mere verbal disclaimer is sufficient, or whether the disclaimer must take the form of removal from the drawing. It is probably true that the

> presence of these words on the seal design would not lead an observer to suppose they were an essential part of the mark; but on the other hand it appears quite feasible to remove them without destroying the essential mark, and in such case any doubts should be removed by erasing them. The mark will be registered upon removal of the words "Moistair Heating System." To this extent the decision of the examiner is reversed. (Rec., p. 15.)

On appeal the Court of Appeals for the District of Columbia affirmed the commissioner and held that the mark as presented was not registerable. In the opinion of Mr. Justice Van Orsdel it was stated:

> It must be conceded that the words "Moistair Heating System" are descriptive of the merchandise on which the mark is used and for which registration is sought. These words standing alone are clearly unregisterable, and are open to public use, limited only by the principles involved in unfair competition. If these words constitute an essential feature of the trade-mark it is sufficient to defeat registration. A mark, certain features of which are merely suggestive of character or quality, is one thing; but a mark like the present, which contains as its dominant feature words aptly descriptive of the character or quality of the goods to which it is applied, is quite another thing. * * *
>
> In the matter of the registration of trademarks the commissioner represents the public. The section of the statute here in question relates primarily to the protection of the public,

and the controlling provision is that which forbids the registration of any mark which may lead to confusion in trade. That being true, the uniform holding of this court that registration of marks will be refused in which descriptive words constitute the dominating figure will be adhered to. (Rec., p. 19.) * * *

The term or trade-name "Moist Air Heating System" is generic, and is descriptive of specific articles of manufacture belonging to one general class of merchandise. The name is common to all, and may be aptly used as descriptive of each. Such a name may not be monopolized as a trade-mark. * * *

By indisputable analogy, it follows that to give the statute the force intended by Congress, primarily to protect the public against confusion in trade, the commissioner may anticipate inevitable confusion and refuse to grant a monopoly in a mark which is not only descriptive in its dominant features, but contains the common trade name of similar commodities in a general class of merchandise. If an applicant can register descriptive words or trade names camouflaged in immaterial and deceptive trimmings, the whole purpose of the statute would be nullified. (Rec., p. 20.)

Opportunity was given appellant in the Patent Office to eliminate from his mark the words "Moistair Heating System" and accept registration of the fanciful portions of the design. Clearly this is all to which he is entitled. *It, however, can be accomplished only by elimination from the registered mark, and not merely by filing a disclaimer in the Patent Office.*

Johnson v. *Brandau* (supra); *Electro Steel Co.* v. *Lindenberg Steel Co.*, 43 App. D. C., 270; *Fishbeck Soap Co.* v. *Kleeno Mfg. Co.*, 44 App. D. C., 6. (Rec., p. 21; italics ours.)

Mr. Chief Justice Smyth concurred with Mr. Justice Van Orsdel on the ground of *stare decisis*, saying:

> It seems to me that if the rule so often announced by this court, either directly or indirectly, is to be changed, it should be done by Congress and not by the court. If, however, the question was one of the first impression, I would join in the conclusion announced by Mr. Justice McCoy. (Rec., p. 21.)

Mr. Justice McCoy, who was sitting on the bench of the Court of Appeals in the absence of Mr. Justice Robb, filed a dissenting opinion (Rec., pp. 21–23), stating:

> It has been decided by this court that a trade-mark which comprises words merely descriptive can not be registered, but that is not what the statute says. I can not see that the proviso in regard to the use of descriptive words needs to be construed, for the language is perfectly plain; but if I am wrong in this then the proper construction of it is made certain by other parts of the section, namely, those where the statute reads, "consists of or comprises."
>
> The trade-mark law is nothing but a registration act. *Elgin Watch Co.* v. *Illinois Watch Co.*, 179 U. S., 665–672. In refusing registration to marks consisting merely in words or

devices which are descriptive the act codified the law found in the decisions because a mark of that kind was not given protection in equity. * * *

In the brief for the Commissioner of Patents it is stated as follows: "The recent decisions of the courts, such as *Nairn Linoleum Co.* v. *Ringwalt Linoleum Works; O. W. Thum Co.* v. *Dickinson*, and others, that have interpreted the statutes, have to some extent changed the practice in the Patent Office, which office is governed by the decisions of the courts."

This is a respectful way of saying that the decisions of this court have revolutionized the practice in the Patent Office so far as concerns the matter here in question. (Rec., p. 22.)

RÉSUMÉ OF PATENT OFFICE PRACTICE AS GOVERNED BY COURT OF APPEALS DECISIONS.

Applications for registration of trade-marks as filed under the act of February 20, 1905, contain a drawing disclosing the mark sought to be registered, a petition praying for registration of the mark, a statement pointing out the particular class of goods upon which the mark has been used and reciting the date of the adoption or use of the mark, a declaration as to ownership, and five specimens of the mark as actually used upon the goods. The certificate of registration, copies of which are purchasable by the public, contains a reproduction of the drawing and a copy of the statement and declaration as approved by the Patent Office.

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Where a mark presented for registration consists merely of descriptive words or devices, registration has uniformly been refused.

The more difficult question arises when the mark comprises both properly registerable matter and improper matter, such as descriptive matter. It is in such cases as this that the decisions of the Patent Office and the Court of Appeals appear to lack consistency, possibly due to the necessity for exercising judgment on questions of fact in each individual case.

Where such composite marks include elements that have been registered by persons other than the applicant, the Patent Office has uniformly required actual eradication of that part of the mark from the drawings—following the decision of the Court of Appeals on this question in *Carmel Wine Company* v. *California Winery*, 38 App. D. C., 1 (191[illegible]. But where such improper matter has not been specifically registered by some other person, and is merely generally objectionable because descriptive or otherwise improper, there appears not to have been such precise uniformity in the rulings of the Court of Appeals as to furnish the Patent Office a guide which could be consistently followed in all such cases.

Prior to January, 1909, when the Court of Appeals decided *Johnson* v. *Brandau*, 32 App. D. C., 348, all applications presenting marks for registration having arbitrary and admittedly registrable matter associated with matter not subject to exclusive appropriation (such as matter descriptive of the goods) were permitted to be registered *in their entirety as*

used. For example, if an applicant presented "Blue Bell Whiskey" for registration, the words being illustrated in the drawing as shown in the specimens, the Patent Office registered the words in their entirety as shown and as used. It was evidently recognized that the word "whiskey" was so obviously not subject to exclusive ownership that it was permitted to remain in the drawing with the arbitrary and registrable matter. To delete the descriptive matter when essential to a part of the combination as used, and where the descriptive matter was obviously public property, was not considered necessary.

If, however, the specimens or labels disclosed, for example, "Blue Bell, a Blended Whiskey," or illustrated the descriptive matter so separated from the arbitrary registrable matter "Blue Bell" that it could be readily omitted from the drawing without mutilating the mark, then the applicant was required to delete from the drawing the descriptive matter, such as "a blended whiskey," thereby limiting the registration to "Blue Bell."

The Court of Appeals in passing on *Johnson* v. *Brandau* held that the applicant should have been denied registration, but have been given an opportunity to amend by disclaiming and omitting the word objected to.

The ground of this decision was that in effect the registration sought was the registration of the word "asbestos" as a trade-mark, or as the essential feature of the trade-mark. It was stated that the

applicant not only described his trade-mark but filed a drawing and did not limit his claim to any particular feature, or claim one as the essential feature of the mark; that having thereby made all the features essential it was not for the commissioner to say that the word "asbestos" was an essential feature or to be regarded as surplusage; that the registration, if granted, would show no such exception or qualification on its face, and the *prima facie* right accorded to registration would apply to the mark as an entirety as shown in the application and drawing.

After *Johnson* v. *Brardau* (supra) applicants were permitted merely to disclaim descriptive words shown in the drawing, where to delete the descriptive words would so show the mark that it would not be readily recognized as the mark shown by the specimens to be the mark used on the goods. Disclaimers directed to words or matter in a trade-mark combination which were obviously not susceptible to individual appropriation when standing alone, were permitted by the Patent Office where the applicant stated no claim was made to the nonexclusive matter "apart from the mark shown in the drawing." (*Illinois Seed Co.*, 219 O. G., 931; 5 T. M. Rep., 85, Jan. 9, 1915.) Such disclaimers became a part of the "statement." When the mark was registered, the illustration forming a part of the certificate disclosed the nonexclusive matter associated in the combination, as used, with the registerable matter. The

statement formed also a part of the certificate of registration and the disclaimer then referred to the nonexclusive matter disclosed in its accompanying illustration.

The trade-mark act of February 20, 1905, does not provide for disclaimers but they were permitted to be filed apparently by analogy to the English law and on the theory that it was but a mere statement of the legal consequence of registering the mark as a whole.

A mark would not be registered where the disclaimer applied to the essential features of the mark leaving only the "mere skeleton of the real mark." This practice followed the decision of the Court of Appeals in the case of *Motz Tire & Rubber Company*, 40 App. D. C., 487 (1913), wherein the court said:

> That the mark which the record discloses the applicant adopted and used is descriptive, and hence nonregisterable, is too plain to admit of argument. Realizing this, the applicant now seeks to register a mark which the record fails to show it has ever used. The Patent Office was therefore quite right in declining to register this fictitious mark, this mere skeleton of the real mark (p. 488).

Until the Court of Appeals in *Fishbeck Soap Co.* v. *Kleeno Mfg. Co.*, 44 App. D. C., 6 (1915), and in *Nairn Linoleum Co.* v. *Ringwalt Linoleum Works*, 46 App. D. C., 64 (1917), disapproved of disclaimers the office did not require the deletion of unessential and recognized nonexclusive matter from the drawing when the disclaimer thereto appeared in the state-

ment. The latter decision, however, held that the "applicant should have been required to omit the objectionable matter from its mark."

The Commissioner of Patents, following the *Nairn Linoleum Company* v. *Ringwalt Linoleum Works* case, began to require, not merely a disclaimer of nonregistrable material, but an actual deletion of the objectionable matter from the trade-mark drawing—and it appears from the Linoleum case opinion that this was what the Court of Appeals had really intended in *Johnson* v. *Brandau*. Evidently, then, the Patent Office mistook the intention of the Court of Appeals following the Johnson case in permitting mere disclaimers at all—and upon this belief, and subsequent to the Linoleum Company case, the Commissioner of Patents has uniformly required the actual deletion of objectionable matter from the trade-mark drawings and denied to applicants the right merely to disclaim and leave the objectionable matter in the drawings.

An apparent exception to this practice, subsequent to the Linoleum Company case, is the case of *Rhynsburger*, 8 T. M. Rep., 467; 128 MS. Dec., 141, decided September 24, 1918, wherein the commissioner held that—

> the applicant should be allowed to restore his drawing to show the words "Specialty," "Fancy Fatter Poultry," and "The Poultry That Made Iowa Famous." The office should register the mark *as used*. Not all descriptive matter should be included, but words and signs in arbitrary and unusual arrangement

should be shown, especially that it now frequently is desirable to register these marks in South American countries,[1] in the form in which they are used. There are decisions in Cuba which hold that a change from a square border as registered to an arched border vitiates the registration. The office should, therefore, be liberal in allowing applicants to include all arbitrary features of their marks.

CONCLUSION.

As the Commissioner of Patents does not wish to assume an argumentative position before this court, we merely summarize the development of the Patent Office practice in handling trade-mark applications comprising in part properly registrable material and in part material not properly registrable.

1. Prior to Johnson v. Brandau (1909).

Prior to the decision of the Court of Appeals in this case, the Patent Office had regularly allowed the showing of both the registrable and nonregistrable material in the drawing of a trade-mark application, not even requiring a disclaimer of the nonregistrable features (except in sporadic instances where actual deletion seems to have been required).

The practical effect of this practice was the misleading of the public to believe that the entire mark as disclosed in the registration was registrable and that the

[1] Trade Mark Convention of 1910—Treaties, Conventions, International Acts, Protocols, and Agreements between the United States and Other Powers (Malloy), compiled by Garfield Charles (Senate Doc. No. 357 of 1913), Vol. III, p. 354.

exclusive right to it, in its entirety, had been demonstrated to the Patent Office and affirmed by the registration. The registrant might then be in a position to assert that the registration covered descriptive matter *per se* against an alleged infringer using that descriptive material alone, or in some combination other than the combination registered by the Patent Office.

2. Subsequent to Johnson v. Brandau.

Following this case, which the Commissioner of Patents understood as so construing the trade-mark act as to require the filing by applicant of a written disclaimer of the nonregistrable portions of his mark, the Patent Office tribunals regularly permitted nonregistrable material to remain in an application drawing (thus showing the mark as actually used upon the goods), but required a written disclaimer in the statement accompanying the drawing—and which appeared in the copies of registrations obtainable by the public—definitely disclaiming the nonregistrable features of the mark, thus giving the public notice of what portions were registrable and claimed as such.

It would seem that no particular harm came to the public by the practice of illustrating the nonregistrable matter in the drawing of the registration and having attached thereto the statement, forming a part of the registration, which contained a disclaimer as to the nonregistrable matter appearing in the accompanying drawing. No one could be deceived as to what was registered, and what was considered the real scope of the mark—that is, the matter subject

to exclusive appropriation. The registrant would, by his disclaimer, be precluded from setting up any claim as to nonregistrable parts.

3. Subsequent to Nairn Linoleum Co. v. Ringwalt (1917).

Following the decision of the Court of Appeals in the above case, the Commissioner of Patents has regularly (as in this case now on *certiorari* before this court) required applicants for such composite mark, not merely to disclaim the objectionable part of the mark, but actually to delete from the drawings all portions thereof except such as were properly registrable—thus showing in the final certificate *not* the mark as actually used in full, but merely what might be called a skeleton mark comprising only such properly registrable features as the original application contained and the Patent Office allowed.

Where material has been deleted from the drawing, because it was not subject to exclusive appropriation, the public is at the disadvantage of observing a difference between the mark as used on the goods and the mark as it appears in the drawing forming a part of the registration. The specimens of the mark as used form no part of the registration certificate, and the public has, in many cases, no convenient means of identifying the disclosure of the drawing with the actual mark as used in commerce.

Respectfully submitted,

FRANK DAVIS, JR.,
Assistant Attorney General.

EDWARD G. CURTIS,
Special Assistant to the Attorney General.

APPENDIX.

SECTION 5 OF THE TRADE-MARK ACT OF FEBRUARY 20, 1905 (33 STAT. 724), AS AMENDED JANUARY 8, 1913.

That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(*a*) Consists of or comprises immoral or scandalous matter.

(*b*) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simullation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be

likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term shall be registered under the terms of this act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further*, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof.